Petition

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ALEXANDER L. STEVAS,
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81-1452

No. _____

IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1982

FORDEES CORPORATION

Petitioner

v.

VULCAN, INC.

Respondent,

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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QUESTIONS PRESENTED

A) Is it reversible error for a Circuit Court, in deciding whether a combination patent has been infringed, to apply a standard for deciding validity of patents, which has not been uniformly recognized by the Circuit Courts as a rule of law?

B) Is it fundamental error and reversible for a Circuit Court to apply the synergism test to the issue of infringement for the first time after formal argument of the cause in the Circuit, thereby expanding a litigant's burden and quantum of proof without affording him the opportunity to confront the issue?

C) Is it reversible error for a Circuit Court to make clearly erroneous findings of fact in support of a determining principle of law, the legal validity of which is in distinct conflict among the several Circuit Courts?

Parent - Mursau Corp.

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STATUTES AND REGULATIONS

28 U.S.C. 1254(1)

TEXTS

Webster's Seventh New Collegiate Dictionary
G&C Merriam Co., Publishers,
Springfield, Massachusetts, U.S. A.
Copyright 1963 ---------- 21

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FORDEES CORPORATION

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VULCAN, INC.,

Respondent

PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

Fordees Corporation prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Sixth Circuit entered in this case on August 14, 1981. A petition for re-hearing was denied by the Circuit Court on October 14, 1981.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Sixth Circuit dated August 14, 1981 is reported at 658 F. 2d 1106 (6th Cir. 1981). The opinion of the United States District Court for the Northern District of Ohio, Eastern District dated February 16, 1978 is reported at 450 F. Supp. 37 (D.C. Ohio, 1978).

JURISDICTION

Jurisdiction in the Federal District Court was based on 28 U.S.C. 1338.

The Court below on August 14, 1981 issued an opinion (A-1) and judgment (A-48) and on October 14, 1981 denied the petition for reconsideration.

Jurisdiction in the Supreme Court of the United States is invoked under 28 U.S.C. 1254(1)(2).

CONSTITUTIONAL PROVISION AND STATUTE

The constitutional provision and the statute involved are:

(a) Article 1, Section 8 - Congress shall have power....To promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and inventions.

(b) 35 U.S.C. 103 - A patent may not be obtained though the invention is not identically disclosed or decribed as set forth in section 102 of this title, if the differences between the subject matter sought to be patented as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

STATEMENT OF THE CASE

This case involves the accused infringement of a patent claiming a combination of prior art elements, U.S. Patent No. 3,166,154, which was issued on January 19, 1965 to the respondent's predecessor John M. Titzel. (Patent identified herein as Titzel-Vulcan). By assignment prior to the instant suit the patent vested in respondent, Vulcan, Inc. The appliance in issue is an industrial scaffolding device entitled "Portable Scaffold and Work Towers" which was developed by Titzel in response to the commercial need of the basic steel industry for a more functional system for re-bricking the inner faces of innovative Basic Oxygen Furnaces developed and put into operation during the early 1960's. The application originally filed on February 2, 1962 was finally issued on January 19, 1965 after two rejections and corrective amendments following a conference with the Patent Examiner. (Complete file history is set forth in Appendix A-21 to 47). On November 23, 1970, respondent's predecessor in interest commenced legal proceedings against accused infringers of the patent at No. CA 70-1333 in the United States District Court for the Western District of Pennsylvania, the named defendants being M. & G. Industrial

Associates Co., Inc. and Robert N. Munroe, hereinafter referred to as Munroe. During the pendency of that suit Munroe sold the instant petitioner a set of work drawings for a portable work tower and lent customer assistance in petitioner's development of a work tower furnace-re-bricking device, which Munroe and petitioner assert though strikingly similar in appearance excluded the single inventive step of the Titzel-Vulcan patent, viz., the manner in which the work tower was supported. Before any pre-trial discovery was initiated by either party in the Western Pennsylvania suit, settlement negotiations were explored, which the defendant insisted were demanded in view of his fiscal inability to maintain an expensive patent infringement defense and against the threat of loss of good will with his steel-maker customers, who were confronted by respondent with assertions of contributory infringement.

The Western District (PA) suit was settled by entry of a consent judgment on October 15, 1971 which duly considered a stipulation of facts dated September, 1971 between the parties pursuant to which Titzel waived any damages against defendants and its customers for any equivalent device already constructed or then under construction. In

consideration thereof, defendants conceded validity of the Titzel patent and admitted that work towers it had built and one under contract by your petitioner infringed the Titzel patent. Titzel through its attorney on March 1, 1971 had informed the petitioner of the Titzel-Munroe litigation accusing possible infringement of its interest by a work tower which petitioner had contracted to build for U.S. Steel Corporation's Gary Works. Thereafter, petitioner and respondent entered protracted negotiations concerning the building by petitioner for respondent of six Oxygen-Lance Hoists together with a license arrangement whereby petitioner would construct and credit the license fees for subsequent work towers similar to the Titzel-Vulcan appliance which petitioner might build. During the negotiations aforesaid which waxed fruitlessly, respondent maintained its stance that petitioner's towers infringed its patent, but never until the pre-trial conference of the instant case asserted that petitioner was in privity with defendants, Munroe, in the Pennsylvania District Court action and thereby subject to contempt proceedings under enforcement of the consent order.

Three and a half years later on May 13, 1975 after collapse of the noted negotiations and after petitioner had

constructed work towers incorporating a support system which was allegedly defined in the prior art of the Titzel-Vulcan patent, the respondent initiated the instant suit in the U.S. District Court in Cleveland, Ohio asserting validity of its patent and acts of infringment by petitioner.

On December 14, 1976 when this matter had been at issue for nineteen months and voluminous discovery undertaken by both parties on the framed issues, the respondent at a continued pre-trial conference orally raised the issue of petitioner's privity with the defendants, Munroe in the prior Western District of Pennsyvania. The docket entries for the said District Court action reflect that respondents amended Complaint raising the privity issue and impact of the prior consent judgment was not filed of record until April 4, 1977, a period of time several weeks later than the close of the record and subsequent to the submission of post-trial briefs of the parties. On the record taken before it the District Court found privity between petitioner and defendants in the 1971 dealings between them and bound petitioner thereby to the consent judgment, foreclosing petitioner's challenge to the validity of the Titzel-Vulcan patent. The Court further

found infringement by petitioner on the basis that its work towers were the equivalent of the patent in issue.

On appeal to the United States Court of Appeals for the Sixth Circuit on the sole issues of privity and the equivalence of petitioner's combination devices, a split panel of the Circuit sustained the District Court's finding of privity between petitioner and the Pennsylvania action defendants thereby foreclosing a review of validity issue. The Circuit Court further sustained the finding of infringement of the accused devices applying for the first time as a measure for defining the scope of respondent's equivalent protection the synergistic result arising from the combination of several prior art elements of the subject patent. The dissent in the Circuit meticulously examining each step of the Titzel-Vulcan combination concluded that (1) the patent appropriated a support system which had been yielded during its file history as prior art; (2) actually operated beyond the scope of its claims and (3) was not infringed by the accused appliance (A-17). Judgment was entered on the Sixth Circuit's opinion to which this petition for writ of certiorari to this Honorable Court is respectfully addressed.

REASONS FOR GRANTING THE WRIT

A) Erroneous Choice of Law

In this unique case the jurisdiction of this Honorable Court is invoked pursuant to 28 U.S.C.A. 1254(1) et seq. principally to review a ruling of the Circuit Court below wherein a questioned principle of law, Synergism, was erroneously applied for the first time upon a patent infringement issue to define the scope of a certain combination patent's range of protective equivalents and the effect of its file history. The issue of Synergism is not posed here as another pedestrian request for this Court to assume jurisdiction and resolve the continuing sharp conflict that rages among the United States Courts of Appeal concerning whether this legal phenomenon (whether principle of law or catch phrase) has a debilitating impact on this Court's definitive pronouncement concerning the validity of combinations as set forth in Graham v. John Deere Co., 383 U.S.1 (1966). That a severe split exists among the Circuit Courts on the premise which was first mentioned by this Court in Andersons-Black Rock, Inc. ". Pavement Savage Co., Inc. 396 U.S. 57 (1969) and Sakraida v. Ag. Pro., Inc. 425 U.S. 273 (1976) has been most recently recognized

and documented by the Court of Appeals for the Third Circuit in Judge Adams' comprehensive opinion in Rengo Co. et al v. Molins Machine Co., Inc. 657 F. 2d 535 (3d Cir. 1981). (See p. 544, fn. 18 in particular for definition of the split among the Circuits.) In this regard it is significant that the Sixth Circuit which has subscribed to synergism as a prerequisite for patentability in Smith v. Acme General Corporation 614 F. 2d 1086 (6th Cir. 1980) relating the concept to newness, has also recognized that as a test it suffers from "definitional deficiencies" and "theoretical flaws"; but then regards it as a "symbolic reminder of what constitutes nonobviousness when a combination patent is at issue." The extended application of the hypothesis in the instant case encourages its proponents that it has not lost any of its clout as a principle in the Sixth Circuit.

It is unequivocal from the force of its own words that the Circuit Court in its opinion below was declaring a controlling principle of law rather than demonstrating its ruling with an illustrative embellishment:

> "...Titzel represents a substantial advance over the prior art through a number of improvements taken in combination. It achieves what is known in the art as "synergy" - the device as a whole

> is greater than the sum of its parts. For this reason, we reject Fordees' narrow reading. (Emphasis added.) (A-13)

The fact that the Court below was impressed by the synergistic effect of the patent in question becomes apparent from a re-reading of the entire opinion.

The legal impact of the Circuit Court's engrafting of a synergism requirement on the infringement issue in question wreaks more harm than merely perpetuating the admitted conflict in the Circuit Courts on the subject. The true force of the Sixth Circuit's action was to mask a suspect combination patent with the wide protection of a pioneer patent, to which it was not legally entitled. See Tate Engineering, Inc. v. U.S. 477 F. 2d 1336 (Ct. Cl., 1973). The adoption of synergistic stance on the Titzel-Vulcan patent brought within the ambit of its equivalence protection unpatentable elements of the prior art and functions which had been surrendered in its file history. In so doing, the Circuit Court below patently disregarded the established policy set forth in Aro Manufacturing Co., Inc. v. Convertible Top Replacement Co., Inc., 365 U.S. 336, 340 (1961), citing Mercoid Corp. v. Minneapolis-Honeywell Co., 320 U.S. 680, 684 (1942) where this Court said:

> "The fact that an unpatented part of a combination patent may distinguish the invention does not draw to it the privileges of a patent. That may be done only in the manner provided by law. However worthy it may be, however essential to the patent, an unpatented part of a combination patent is no more entitled to monopolistic protection than any other unpatented device."

Correspondingly, when "substantially the same test" was applied against this erroneous framework, the accused patent was compared on a broad base of invalid elements instead of the narrow equivalence of a suspect combination patent. FMC Corp. v. F. E. Myers & Bro. Co., 384 F. 2d 4, certiorari denied, 390 U.S. 980 (6th Cir. 1967).

Consequently, petitioner was then held accountable in a comparison of the equivalence of his device with the patent, not for copying the inventive step, the manner in which the device was supported, but more emphatically for each step or function of the combination contraption, including measures which had been excluded in its prolonged prosecution before the Patent Office. Likewise significant in both the Circuit Court's opinion and that of the District Court was the failure of the Courts' to exercise the duty "to scrutinize combination claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old

elements." Great A&P Tea Co.v. Supermarket Equipment Co., 340 U.S. 147, 152 (1950).

Petitioner submits further that the application of the principle not only minimized his defense of non-equivalents but virtually nullified his right to rely on the file wrapper estopped representations of the prior art restrictions surrendered by the patentee before the Patent Office which the Circuit Court nevertheless added back to its synergistic mix. This fundamental error perpetrated by the Court below has operated to petitioner's detriment and flies squarely in face of the constitutionally mandated public policy considerations against unlawful extension of a patent holder's limited monopoly. See concurring opinion of Justice Douglas in Great A&P Tea, supra, p. 155.

Further, the application of the questioned principle as enumerated now poses the ominous potential of generating a new conflict between the Sixth Circuit where this proposition was announced in these proceedings and the other ten Circuits where it has never been recognized as a rule of law. What curious or confused results may flow from this Sixth Circuit pronouncement must abide only the ingenuity

of counsel in future infringement suits in that Circuit and wherever else availed upon as decisional authority.

Petitioner respectfully requests that this Honorable Court remand thus cause to the United States Court of Appeals for the Sixth Circuit for examination and determination under the governing case law.

B) Lack of Notice of Applicability of Controlling Rule of Law

Petitioner asserts that when in its opinion of August 14, 1981 the Circuit Court below made the application of law set forth above, the proposition was posed in these proceedings for the first time. Synergism as a measure for determining equivalents protection and the applicability of file wrapper estoppel had not been urged by respondent before the Trial Court or in its argument before the Sixth Circuit. Nor did the Circuit Court panel hearing the case call for supplemental oral argument or briefing of the issue. Petitioner, therefore, was not aware until after his appeal, that the Circuit Court considered his burden and quantum of proof on issues controlling the outcome of the case broader than as framed by the pleadings and actually addressed at the trial on the merits.

The effective procedural practice in the Seventh Cicuit Court of Appeals and other Circuits of requesting additional materials or "Letter-Briefs" to supplement issues which arose at the formal argument was not utilized by the hearing panel of the instant Circuit.

The interjection of the issue into its opinion as noted above had the legal consequence of expanding the petitioner's burden and quantum of proving non-equivalence and acutely restricting his defense on the grounds of file wrapper estoppel. Petitioner was not extended a fair opportunity to brief or argue the new issue and was thereafter confronted with a determination against his interest under which his burden of proof had been drastically altered after the issues had been tried and wherein he had no opportunity to object.

The injustice was compounded further when upon filing of his petition for reconsideration, the Circuit Court confronted with a legal mechanism for correcting its obvious mistake by way of reargument, nevertheless summarily denied the reconsideration request and confirmed its prior order. (The Honorable Charles W. Joiner re asserted his dissent.)

Petitioner respectfully asserts that the arbitrary alteration of a litigant's burden and quantum of proof during

the course of a legal proceeding under circumstances wherein he was deprived of the opportunity to answer and argue fully the issue offends against all requirements of fair play in the judicial framework. The said action of the Sixth Circuit amounts to clear fundamental error and further compounds the mistake of applying the acutely questioned Synergism proposition into the cause as a controlling principle on the issue of patent infringement.

Petitioner prays that this Honorable Court accept jurisdiction to remedy the error by remand of thus cause to the Sixth Circuit Court of Appeals for a review and re-argument according to lawful precedent as prayed for above.

C. Clearly Erroneous Finding of Facts and Conclusions of Law

Petitioner further represents that the Courts below rendered clearly erroneous findings of fact upon which the legal conclusions were drawn and confirmed by the final order. Petitioner therefore requests that this Court under its appellate jurisdiction undertake an independent examination of the factual issues which the petitioner assigns as clearly erroneous. Marconi Wireless Telegraph v. United

States 320 U.S. 1.44 (1943); Zenith Radio Corp. v. Hazeltine Research, Inc. 395 U.S. 100, 101 (1969). Petitioner asserts that the confusion which the Courts below endeavored to unravel was it no small part wrought by the polysyllabic patentese in which the instant claims were written in indifference to Judge Thurman Arnold's caveat in Monsanto Chemical Co. v. Coe, 145 F. 2d 18, 19 (D.C. Cir. 1944). It is further asserted that the oblique language employed in the claims may have caused the courts below to confuse unpatentable functions with "means." In this regard see Judge Learned Hand dissenting in Bragg-Kliesrath Corp. v. Farrell, 2 Cir., 1929, 36 F. 2d 945, 954:

> "Courts keep repeating that a function is not patentable and there is indeed the highest authority for saying so. Yet I suppose that nine claims out of ten are drawn for 'means' for doing this or that. What this is but a claim for a 'function' I have never been able to see. If there be any such rule, it seems to me more honored in the breach than in the observance; surely it cannot be that it can be evaded by so simple a device as the use of this nearly universal word."

The presumption that a patent writer is his own lexicographer and must stand the burden of obscuring the scope of his claim, likewise exposes him to the risk that his patent may be found to operate beyond the scope of his claims when he asserts infringement.

On the contested issue of what was patented here, respondent has asserted and the lower courts have accepted that his invention was a work tower, combining several new measures which had windfall results when adapted to relining the inner walls of Basic Oxygen Furnaces for its steel maker customers. Petitioner's counter contentions allege that the Titzel-Vulcan patent combined several prior art elements, all of which had been excluded as un-patentable by the Patent Examiner during its extensive prosecution in the Patent Office and left for the Court's determination the sole issue of whether the inventive element was the manner in which the appliance was supported and stabilized. The zealous effort of the patentee's counsel to abhor all overhead support is patently clear in each step analyzed in the remarks which accompanied his final application (A-40 to 42). Support from other than the base was prior art and he religously avoided claiming it.

The text of Claim One against which the instant infringement was asserted is set forth in the opinion of the Circuit Court (A-12); the entire file history of the patent is set forth in pages A-21 to 47.

Translating the Titzel-Vulcan patent into layman parlance, the device in question appears to be a four sided metal scaffold, equipped with a service elevator installed within the framework of the scaffold, and a work platform that surrounds the scaffold and can be adjusted to the desired work level on tracks on the scaffold's outer sides. The elevator and work platform operate independently of one other and were coupled to remain in place at the appropriate work level. This combination of mechanical elements received industry wide acclaim and utility when it was installed in Basic Oxygen Furnaces for the purpose of relining the interior of the steel making chambers with refractory brick. The device was claimed to be "free standing" relying for its stability entirely on the support that it received from the pressure of its own weight against the floor of the steel-making vessel. However, in view of respondent's expert witness' testimony "that if the former were supported only by the base means it would not be stable and thus not free-standing.", it is understandable that he looked elsewhere in his claims for a support system for the tower which would work. That he confused the Circuit Court is obvious from the emphasis placed on the function of the work platform which

was surrendered in the Patent Office as prior art (A-8-italized quotation). This means supported the work platform and not the tower itself as the dissent sought to correct:

> "This aspect of the tower does not provide support for the tower, but is the means by which the work platform is supported. (A-13)

Petitioner, in the trial of the case, asserted as a defense to its accused infringement, the rejection by the Patent Office as unpatentable of: the adjustable work platform (A-28), the collapsible aspect of the said working platform (A-28), the adjustable set screws that leveled the bottom edges of the scaffold (A-29) and the installation of an elevator within the scaffold (A-28). In response to respondent's claimed novelty for installing the device in a Basic Oxygen Furnace which made it a commercial success, the Patent Examiner found that where the patentee opted to use the device was a matter of choice and not an inventive step (A-35). The petitioner, on the other hand, has asserted that his entire device has copied only prior art elements including overhead support measures.

Most troublesome to the reviewing split panel of the Sixth Circuit below in deciding the issue of support for the

device was the precise extension and connotation to be given the word "free-standing" which appeared in the claims of the patent for the first time in the re-submitted application that was eventually approved by the Patent Office (A-49). While the record of the trial reflects a liberal meaning given the term by a mechanical engineer in 1976, the fact remains that a third party concerned with the accepted meaning of the expression contemporaneous with the promulgation of the patent in 1964 unembellished by a professional opinion twelve years later, would discover upon "looking up the meaning" in an universally accepted lexicography a short but graphic definition. See Webster's Seventh New Collegiate Dictionary, G&C Merriam Company, Publishers, Springfield, Massachusetts, U.S.A., Copyright 1963 by G&C Merriam Co., at page 333:

> "freestanding adj.: standing alone or on its own foundation free of architectural or supporting frame or attachment". (Emphasis added).

Viewed in this context, the Titzel-Vulcan patent could reasonably be interpreted at the time of its grant, as a work tower which depends for stability and support on its own weight, the natural pull of gravity to hold it securely in place. Apropos of this point, is this Court's rejection of the dependence upon gravity of a challenged patent in

Sakraida, supra, wherein Justice Brennan, in discussing the prior art of the proffered patent, compared it to the resolution of King Augeas' long-standing sanitation problem in the fifth labor of Hercules.

Further addressing itself to the element of gravity flow and its effect on patent integrity, this Court in Sakraida p. 282 (supra) observed:

> "Exploitation of the principle of gravity adds nothing to the sum of useful knowledge where there is no change in the respective functions of the elements of the combination; this particular use of the assembly of old elements would be obvious to any person skilled in the art of mechanical application."

The correct factual characterization of the non-equivalence of the accused device was therefore given in Judge Joiner's meticulous step-by-step dissection of the claimed patent, wherein recognizing the only invention step in issue, he held:

> "The patent teaches sole base means support, and the method of support utilized by the defendant is substantially different from that claimed in the patent, and is simply not the equivalent. The use of a means to support the tower from the service floor cannot be considered the equivalent because this means of support is described in the prior art (Laaback patent). (A-20) (A-28).

The petitioner, therefore, prays that upon asssumption of jurisdiction, this Honorable Court review the erroneous

findings of fact and remand the cause for correction in accordance with the findings of District Judge Charles W. Joiner in his well reasoned minority opinion.

CONCLUSION

For the foregoing reasons, a writ of certiorari should be issued.

Respectfully submitted,

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Appendix

No. 78-3325

UNITED STATES COURT OF APPEALS

FOR THE SIXTH CIRCUIT

VULCAN, INC.,
Plaintiff-Appellee,

v.

FORDEES CORPORATION,
Defendant-Appellant.

ON APPEAL from the United States District Court for the Northern District of Ohio.

Decided and Filed August 14, 1981

Before: MARTIN, Circuit Judge; CELEBREZZE, Senior Circuit Judge; and JOINER, District Judge.*

MARTIN, Circuit Judge, delivered the opinion of the court, in which CELEBREZZE, Senior Circuit Judge, joined. JOINER, District Judge (pp. 25-30), filed a separate dissenting opinion.

MARTIN, Circuit Judge. Fordees Corporation appeals from a judgment of patent validity and infringement. The issues before us concern the res judicata effect of a prior consent decree and the doctrine of equivalents. Specifically, Fordees argues: 1) that it was not in privity with the prior defendant and is therefore not bound by the determination of patent validity in the consent decree; and 2) that devices it built after entry of the decree do not infringe the patent.

The patent in dispute is the "Titzel" patent, granted to Titzel

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* Honorable Charles W. Joiner, United States District Judge for the Eastern District of Michigan, sitting by designation.

Engineering, Inc. on January 19, 1965.[1] The current owner of the patent is Vulcan, Inc., the plaintiff below. The patented and accused devices in this case are portable work towers, or "reline" towers, used in rebuilding the refractory lining of basic oxygen furnaces in which steel is made. These furnaces are lined with thick brick walls which retain the molten metal and insulate the vessel from the extreme heat that is generated. The heat eventually destroys the refractory lining, which must be replaced periodically. Since the relining process takes a vessel out of service temporarily, the lining must be replaced as quickly as possible.

Before the Titzel tower was introduced to the industry, it was necessary to build a wooden or metal scaffold from the ground up inside each vessel. This procedure took several days to complete and required two work crews, one to build the scaffold, the other to replace the refractory lining. It was also dangerous because bricks, lowered by a crane from the top of the vessel to the scaffold, could easily fall on the workers.

The Titzel tower substantially changed the relining process. It is a portable free-standing structure that collapses to fit through the narrow chimney of an oxygen furnace. Its working platform can be raised or lowered easily to different levels. A guided elevator cage transports bricks and other materials to the platform. Thus, the Titzel tower eliminates both the danger of falling brick and the inefficiency of building and disassembling scaffolds. It also enables use of the overhead crane for other jobs. Finally, it increases potential steel production by substantially reducing the time required to reline a vessel.

In 1970, Vulcan's predecessor, Titzel Engineering, brought an action in the Western District of Pennsylvania against M&G Industrial Associates and its president, Robert Munroe, for infringement of the Titzel patent. (W.D.Pa. Civ. Act. #70-1333). Titzel claimed that M&G had infringed the patent by manufacturing and selling reline towers.

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[1] U.S. Letters Patent No. 3, 166,154.

Early in 1971, Munroe contacted Fordees' president and told him about the Titzel patent. Fordees, M&G and Titzel were then bidding against each other for a contract to build a reline tower for the Gary Works of United States Steel Corporation. Although Fordees had never built a reline tower, it submitted a bid based on a plan or "cartoon." U.S. Steel accepted this bid and signed a purchase order with Fordees. As a condition of the contract, Fordees specifically agreed to hold U.S. Steel harmless from potential infringement of the Titzel patent.

After its bid was accepted, Fordees purchased from M&G a set of engineering drawings containing specifications for the construction of a reline tower. These drawings were M&G's principal asset; its practice was to subcontract construction work to firms which bought the drawings. Fordees purchased these drawings with knowledge that the reline tower they described was the subject of a patent infringement suit. Fordees also obtained technical assistance and engineering advice from M&G, after purchasing the drawings. Because of the pending litigation, Fordees insisted that M&G indemnify it against liability for infringing the Titzel patent.

Fordees then began to construct a reline tower for the Gary Works. Except for minor dimensional changes, it adhered to the specifications set out in the M&G drawings.

On October 14, 1971, Titzel's suit against M&G and Munroe ended with the entry of a consent decree and accompanying stipulation. The decree declared the Titzel patent both valid and infringed. Both M&G and Munroe agreed to stipulate that the reline tower described in the engineering drawings sold to Fordees infringed the patent. They also agreed to return the drawings to Vulcan, Inc. According to the decree, M&G had built four infringing reline towers and had further infringed by supplying Fordees with the drawings and technical assistance.[2]

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[2] The District Court stated, not quite accurately, that "the judg-

In the settlement, Vulcan agreed to release M&G and Munroe from liability for any acts of infringement completed before the date of the decree, intending by this clause to release Fordees from liability for the reline tower it was then building for the Gary Works. After the decree was entered, M&G and Munroe dissolved their reline tower business.

In 1973, Fordees began to construct additional reline towers. It bid for and obtained a contract to build a second tower for the Gary Works. As part of that contract, Fordees again agreed to hold U.S. Steel harmless against infringement of the Titzel patent.

On the basis of the foregoing facts, the District Court concluded that Fordees was in privity with M&G and was therefore bound by the 1971 consent judgment:

> Where, as here, during the pendency of a patent infringement suit, Fordees acquired from the defendant in the suit property rights to designs and engineering and technical assistance permitting Fordees to manufacture the device which is the subject of that suit; where such acquisition is made with full knowledge of the pendency of the suit; where the defendant in the suit agreed to indemnify Fordees for any damages resulting from Fordees' infringement of the patent in suit; where a consent judgment was negotiated in the action which benefitted Fordees; and where the consent judgment holds the patent valid and infringed; the Court finds Fordees is in privity with the defendant in the suit. See *A. W. Schnitger* v. *Canoga Electronics Corp.*, 462 F.2d 628 (9th Cir. 1972); *J. R. Clark Co.* v. *Jones & Laughlin Steel Corp.*, 288 F.2d 279 (7th Cir. 1961), *cert. denied* 368 U.S. 828 (1961); *Alb, Inc.* v. *Noma Lites Inc.*, 231 F.2d 662 (2d Cir. 1956).

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ment found that five reline towers infringed the Titzel patent, four of which were made by M&G and one of which was made by Fordees in connection with M&G."

The court also found that the reline towers built by Fordees after the consent decree infringed the Titzel patent. We shall deal with those issues separately.

I. Privity

We must first decide whether the District Court erred in finding that Fordees and M&G were privies with respect to the subject matter of the prior consent decree. If Fordees was in privity with M&G, then the 1971 judgment is res judicata and Fordees may not reexamine the validity of the Titzel patent.

Whether privity exists in a given case is a question of fact. *Harrison* v. *Bloomfield Bldg. Ind., Inc.*, 435 F.2d 1192 (6th Cir. 1970); *Astron Ind. Assoc.* v. *Chrysler Motors Co.*, 405 F.2d 958 (5th Cir. 1968); *Crane Boom Life Guard Co.* v. *Saf-T Boom Co.*, 362 F.2d 317 (8th Cir. 1966), *cert. denied*, 386 U.S. 908 (1966). The scope of our review is therefore limited, and we must uphold the District Court's findings unless they are clearly erroneous. Fed.R.Civ. Proc. 52(a).

Fordees contends that it was not a successor in interest to M&G, that it never acquired a property interest in the Titzel patent, and that it received no benefit from the consent decree. According to this argument, Fordees was merely "under license" to use the M&G drawings, having bought nothing "tangible" from M&G "except, perhaps, the paper on which the designs appeared."

This argument is unpersuasive. "Privity" is an ambiguous term, a shorthand designation for those persons who "have a *sufficiently close relationship* with the record parties to be bound by the judgment." Note, *Developments in the Law — Res Judicata*, 65 HARV. L. REV. 818, 856 (1952) (emphasis added). Our review of the record discloses ample evidence that Fordees' relationship with M&G was in fact "sufficiently close" to establish privity.

First, Fordees was more than a "mere purchaser" of a manu-

factured product. *See Gen. Chem Co.* v. *Standard Wholesale Phosphate & Acid Co.*, 101 F.2d 178 (4th Cir. 1939). *See also Brunswick* v. *Chrysler Co.*, 408 F.2d 335 (7th Cir. 1969); *J. R. Clark Co.* v. *Jones & Laughlin Steel Co.*, 288 F.2d 279 (7th Cir. 1961), *cert. denied*, 368 U.S. 828 (1961). For our purposes, U.S. Steel, rather than Fordees, must be considered the ultimate purchaser of the reline towers.

Second, the record reveals that Fordees acquired the substance of the Titzel patent from M&G during the course of the litigation which ended in the consent decree. The fact that Fordees did not obtain "title" to the drawings is immaterial. The important point is that the drawings enabled Fordees to construct a reline tower to fulfill its contract with U.S. Steel. Indeed, without the plans, Fordees would not have been able to build any type of reline tower, much less a Titzel reline tower. By obtaining the technical knowledge embodied in M&G's engineering drawings, Fordees acquired a significant interest which facilitated its business. In *G&C Merriam Co.* v. *Saalfield*, 190 F. 927 (6th Cir. 1911), this court upheld a finding of privity on similar facts. Although the nature of the "substantial right" was never precisely established in that case, we held:

> What was the precise nature of the contract between [the parties] does not appear . . . . The court might well presume, if need be, that the contract was only of an agency and did not transfer a substantial right. But it is not material. The case was already pending, and the whole controversy had been submitted for the judgment of the court. Though not a party, Saalfield was bound by the final decree of the court. If a third party may thus come into the acquisition of rights involved in pending litigation without being bound by the final judgment, and require a suit de novo in order to bind him, he might, pending that suit, alienate that right to another with the same result, and a final decree bearing fruit could never be reached.

Id. at 938.

Third, it is well established that one interest sufficient to bring a non-party within the ambit of res judicata is a legal duty, right, or interest dependent wholly or in part on the outcome of a lawsuit. *Moore, Federal Practice* 1B ¶ 0.411(6). Here, Fordees' right to build reline towers according to M&G's plans was dependent on the result of the Pennsylvania litigation. Furthermore, Fordees insisted that M&G indemnify it against potential liability for patent infringement, thereby establishing another right which hinged on the outcome of the Titzel-M&G lawsuit. Finally, we point to the fact that Fordees agreed to hold U.S. Steel harmless against infringement liability for the Gary Works tower. Both Fordees' right to indemnity and its duty to indemnify depended in part on the pending litigation.

Professor Moore suggests that an indemnitor has sufficient interests at stake to be bound as a privy by a judgment. We think an indemnitee also has a sufficient interest, at least in a case such as this one in which the indemnitee itself agrees to indemnify a third party with respect to the subject matter of the litigation. *See Schlegel Man. Co.* v. *USM Co.*, 525 F.2d 775 (6th Cir. 1975), *cert. denied*, 425 U.S. 912 (1976); *American Safety Flight Systems, Inc.* v. *The Garrett Co.*, 528 F.2d 288 (9th Cir. 1975); *In re Skyline Lumber Co.*, 311 F.Supp. 112 (W.D.Va. 1970).

Fourth, Fordees continued to deal with M&G and Munroe after entry of the consent decree. It obtained a full set of reline tower engineering drawings from M&G, which it used to build additional reline towers. In addition, Fordees succeeded M&G as a major supplier of reline towers and reline tower technology when M&G dissolved at the conclusion of the lawsuit. These facts convince us that Fordees was a successor in interest to M&G. *J. R. Clark* v. *Jones & Laughlin Steel Co., supra.*

Fordees attempts to distinguish *Clark* by noting that the successor in that case acquired all the assets of the predecessor, whereas Fordees obtained only the right to use M&G's draw-

ings. This distinction is without merit, for the record indicates that the only substantial assets M&G ever possessed were the very engineering drawings that Fordees acquired.

We also reject Fordees' argument that a successor in interest must formally take over its predecessor's business. In *Schnitger* v. *Canoga Elec. Co.*, 462 F.2d 628 (9th Cir. 1971) (*per curiam*), the court found privity between a prospective buyer of infringing products and their manufacturer, who had previously been enjoined from selling them. This derivative successive interest to the same property right was sufficient to establish privity. *See Amer. Equip. Man. Co.* v. *Wikomi Man. Co.*, No. 79-1960, slip op. at 3, n. 1 (7th Cir. Sept. 22, 1980).

Federal courts are no longer bound by rigid definitions of the parties or their privies for purposes of applying res judicata or collateral estoppel. *Jackson* v. *Hayakawa*, 605 F.2d 1121 (9th Cir. 1979), *cert. denied*, 445 U.S. 952 (1980). *See also Montana* v. *United States*, 440 U.S. 147, 155-158 (1979). The evidence in the record convinces us that Fordees' interests were "so closely aligned" with those of M&G that they were fairly represented in the Pennsylvania proceedings. *See Aerojet-General Co.* v. *Askew*, 511 F.2d 710 (5th Cir. 1975), *cert. denied*, 423 U.S. 908 (1975). *See also Jefferson School of Soc. Science* v. *Sub. Act. Control Bd.*, 331 F.2d 76 (D.C.Cir. 1973).

Finally, Fordees invites us to examine the economic circumstances that precipitated the consent decree. Fordees argues that it entered the consent decree under economic duress, therefore the decree should not have res judicata effect. While we recognize that fear of a treble damage award[3] might be a significant incentive to settle a case, we also recognize that negotiations for a consent decree invariably call for reciprocal compromises — each party relinquishes something it might have won had it proceeded with the litigation. Langsam, *Res*

[3] 35 U.S.C. § 284 (1952).

Judicata Effects of Consent Judgments in Patent Infringement Litigation, 36 FED. BAR J. 171 (1977). We note that consent decrees are subject to a sufficient degree of judicial supervision to protect the parties from coercion and economic overreaching. *See Schlegel Man. Co.* v. *USM Co., supra.* Therefore, we refuse to engage in *ad hoc* examinations of valid consent decrees. *See American Equip. Co.* v. *Wikomi Man. Co., supra.*

We reiterate the view we expressed in *Schlegel*, that we wish to encourage settlement in patent litigation. *See also Wallace Clark & Co.* v. *Acheson Ind., Inc.*, 532 F.2d 846 (2d Cir. 1976), *cert. denied*, 425 U.S. 976 (1976); *Aro Co.* v. *Allied Witan Co.*, 531 F.2d 1368 (6th Cir. 1975), *cert. denied*, 429 U.S. 862 (1976); Langsam, *supra.* The strong public interest in achieving finality in litigation is advanced by giving res judicata effect to consent decrees. We decided in *Schlegel* that the interest in finality outweighs the interest in limiting patent monopolies, absent a strong overriding policy. *See also Wallace Clark & Co., Inc.* v. *Acheson Ind., Inc., supra;* Note, *Bar and Merger Treatment of Consent Decrees in Patent Infringement Litigation*, 74 COLUM. L. REV. 1332 (1974). We see no reason in this case to exalt the purely private, economic interest advanced by Fordees above either of the competing public interests present in *Schlegel.*

II. Infringement

The second issue we face is whether the reline towers that Fordees built after the consent decree infringe the Titzel patent. The validity of a patent and its interpretation are both questions of law, which may depend upon factual inquiries. Infringement, on the other hand, is a question of fact. *Weidman Metal Masters* v. *Glass Master Co.*, 623 F.2d 1024 (5th Cir. 1980); *Schlegel Man. Co.* v. *USM Co., supra.* In *Weidman*, the Fifth Circuit summarized the principles of review we must apply to the infringement issue:

> A patent is obviously infringed if the accused device

incorporates its teaching literally read. In reading a patent to determine whether it has thus been infringed, its claims must be read in connection with its specifications and its file history; the patent's claims cannot be construed to reach beyond the teachings expressed in the patent. Minor modifications are, therefore, sufficient to avoid literal infringement. Such alterations may, however, result in a device that appropriates the invention and incorporates its innovative concept into a device that performs substantially the same function in substantially the same way to obtain substantially the same result. The "doctrine of equivalents" protects the patent and its inventor from such abuse.

The ultimate question, as the title of the rubric implies, is whether the accused device is functionally equivalent to the patented one. What constitutes equivalency is determined in the context of the scope of the prior art, the nature of the patent, the real invention disclosed by its specifications and examples and the extent of innovation accomplished. A pioneer patent disclosing a function never before accomplished is entitled to broader protection than one that makes minor improvements on known technology. The range of equivalents is also limited by the patentee's surrender or amendment of claims in response to demands of the patent examiner, a process that creates "file wrapper estoppel." 623 F.2d at 1026.

A. The Doctrine of Equivalents

The District Court decided that Fordees' subsequent reline towers were substantially equivalent to the reline towers covered by the Titzel patent. The court scrupulously compared the Fordees towers with both the Titzel patent and the M&G towers challenged in the Pennsylvania litigation. It found that the Fordees towers appropriated neither the precise mode of support — "base means support" — taught by Claim I of the patent, nor the specific method of connecting the carrier means with the coupler means. Nevertheless, the court found

these modifications too minor to avoid substantial equivalence. The Fordees towers appropriated Titzel's basic principle and mode of operation as "normally free-standing reline towers":

> "Free-standing" requires that the structure remain stable in position without the use of support means such as cables, overhead cranes and special frames brought in for the specific purpose of holding it in place. Each of the Fordees reline towers is stable in position on a primary foundation at the service floor with various means to stabilize and support the tower within the vessel. Admittedly, no cables, braces, overhead cranes or other ancillary devices are brought in for the specific purpose of maintaining the stability of the structure. The requirement that the tower be free standing does not require or imply that the structure is totally supported from its bottom or base.

Fordees' primary argument on the infringement issue is that "base means support" is the heart of the Titzel patent. Fordees claims that its own reline towers do not incorporate base means support and thus do not literally infringe Titzel. It presses further and argues that a tower without base support means cannot be equivalent to the Titzel reline tower.

The District Court decided that the essence of the Titzel patent is a free-standing tower and not merely base support means. Therefore, Fordees' single omission or modification of base support means was not a material change that would avoid infringement. We find no legal or factual basis on which to disagree. As the court below noted, "incorporation of each and every element, without exception, of every claim of a patented structure is not an absolute prerequisite to a finding of infringement by an accused structure," *citing Clarage Fan Co.* v. *B&F Sturtevant Co.*, 148 F.2d 786 (6th Cir. 1947).

As we interpret the Titzel patent, with reference to the language of the patent claims, its file wrapper history, and the prior art, we agree that base support means is not the heart

of the invention. A careful reading of Claim I[4] of the patent itself reveals that the Titzel tower is not in fact solely supported by base means. Additional supports are called for to produce a free-standing structure. The following language calls for two means of support:

> A portable work tower particularly adapted for use in vessels having an opening smaller than the interior comprising an elongated tower means adapted to pass through the opening in said vessel *and be normally free standing*, said tower means including upper and lower portions having spaced apart vertically extending members at the corners of a quadrangle, said vertically extending members on the lower portion being provided with carrier means vertically movable thereon, *base means on the lower portion adapted to engage the vessel bottom at spaced apart adjustable level points whereby the tower may be leveled and supported, a plurality of support arms spaced about said carrier means and pivoted thereon from a position parallel to the lower portion of the tower* to a position transverse to the tower means to form a working platform, spaced cage guides within the upper and lower portions forming an inner cage guide extending from adjacent one end of the tower to the opposite end of said tower, cage means vertically movable on said cage guides within the upper and lower tower portions and lift means on the tower means selectively raising and lowering the cage means, said cage means being selectively coupled with said carrier means for raising and lowering said carrier means with said cage means. (emphasis added).

By its terms, then, the patent does not solely teach base support means.

Furthermore, Dr. Romualdi, an engineering expert, testified at trial that a reline tower resting solely on feet at its base

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[4] Claim I is the only claim of four in the patent that has allegedly been infringed.

would be an unstable structure that would inevitably collapse under an eccentric load. He also confirmed that the Titzel patent taught several means of support, including a plurality of support arms. In addition to providing support for the tower itself, these support arms form the tower's working platform.

Vulcan's Exhibit 99, a specification for the Titzel patent, shows that the tower is actually supported by a trunnion ring across its waist, which allows rotation around a pivot point. According to Dr. Romualdi, "base support means" is a term of art broad enough to include any device below the waist or trunnion rings, and "top support" means anything above.

Our review of the prior art reinforces the conclusion that base support means is not the heart of Titzel. One of the significant advances Titzel achieved was the introduction of a "*free-standing*" tower. No relining device found in the prior art can be described as "free-standing." On the contrary, all require support from some point outside the vessel in which they are operating.[5]

From the foregoing examination of the Titzel patent and the prior art, we conclude that the District Court's interpretation of Titzel is legally correct. The patent's grant is broad enough to encompass a free-standing reline tower, not one which relies solely on base support means. Titzel represents a substantial advance over the prior art through a number of improvements, taken in combination. It achieves what is known in the art as "synergy" – the device as a whole is greater than the sum of its parts. For this reason, we reject Fordees' narrow reading.

We also find substantial evidence in the record to support the District Court's conclusion that the reline towers constructed by Fordees after the consent decree fall within the

[5] Relining devices in the prior art include: Myers, U.S. Letters Patent No. 1,380,074; Laabeck, No. 2,563,682; Arnold, No. 2,933,918; and Abarotin, No. 3,033,389.

claims of the Titzel patent under the doctrine of equivalents. *See Graver Mfg. Co.* v. *Linde Air Products*, 339 U.S. 605 (1950); *Olympic Fastening Systems, Inc.* v. *Textron, Inc.*, 504 F.2d 609 (6th Cir. 1974), *cert. denied*, 420 U.S. 1004 (1975). Dr. Romualdi testified repeatedly and without contradiction that there is no functional difference between the Fordees towers, and the M&C tower and the Titzel patent. Furthermore, the specifications for the Fordees towers in plaintiff's exhibits 99 through 106 show virtually identical structures.[6] This evidence supports the District Court's finding of equivalency. *See Arco Ind.* v. *Chemcast Co.*, No. 77-1501, slip op. at 9 (6th Cir. Aug. 28, 1980).

B. File Wrapper Estoppel

Finally, we must consider whether the prosecution history, or "file wrapper," of the Titzel patent will operate to remove Fordees' towers from the patent's ambit. *See Graham* v. *John Deere Co.*, 383 U.S. 1 (1966). The Supreme Court summarized the doctrine of "file wrapper estoppel" as follows:

> It is well settled that where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to *narrow* his claim by the introduction of a *new element*, he cannot after the issue of the patent broaden his claim by *dropping* the element which he was compelled to include in order to secure his patent . . . The patentee is thereafter estopped to claim the benefit of his rejected claim or such a construction of his amended claim as would be equivalent thereto. (citation omitted) So where an applicant whose claim is rejected on reference to a prior patent, without objection or appeal, voluntarily restricts himself by an amendment of his claim to a specific structure, having thus narrowed his claim in order to obtain a patent, he "may not by construction, or by resort to the

[6] See Appendix.

> doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments which amount to a disclaimer."

Arco Ind. v. *Chemcast Co., supra,* slip op. at 6, *quoting I.T.S. Co.* v. *Essex Co.,* 272 U.S. 429, 443-44 (1926) (citations omitted and emphasis added).

Fordees contends that Vulcan, having previously argued before the Patent Office that the tower is supported solely from the bottom, is now estopped from claiming that the heart of its invention is a free standing tower.

This would be a classic case for file wrapper estoppel if Titzel's original claim had described a free-standing tower and if the Patent Office had required the inventor to narrow his claim to recite support by base means alone. Were those the facts, Vulcan would indeed be estopped from seeking the benefit of the rejected claim and would be limited to prosecuting towers with base means of support. This court recently observed that the "classic application of file wrapper estoppel occurs where a broad claim is narrowed to secure a patent. The patentee is thereafter estopped from asserting that his patent has the scope originally claimed before the narrowing amendment." *Arco Ind.* v. *Chemcast Co., supra,* slip. op. at 5.

However, the Titzel file shows that the patent ultimately granted is actually *broader* in scope than the description of the original claims. Thus, this case is the reverse of *Arco.* Titzel's original and first amended applicatons called for "base means support," remarking that the device was the first to derive its *major* support from the bottom and to eliminate all top support. The Patent Office rejected these applications, whereupon Titzel submitted a different set of claims.

The inventor's remarks in support of the new claims, which were eventually accepted, did not limit discussion to base means support. Rather, they described the device as one "supported entirely by the vessel" and as a "tower structure

. . . in which all of the support comes from the vessel within which the tower is operating." The patent as issued describes a "free-standing" structure. As we observed earlier, "free standing" does not imply support from the bottom. Rather, in the language of engineers, it implies stability and self-sufficiency.

Furthermore, Fordees has taken the remarks in Titzel's file history out of context. The language is not as limited as Fordees suggests. It in fact describes a free-standing tower in numerous references. For example: "(the tower is) supported entirely by the vessel in which the work is progressing." Distinguishing the Titzel invention from the Arnold and Abarotin patents, the remarks state, "Both require a separate supporting device;" and, in contrast to a third previous patent, "there is no suggestion in Laaback of a tower structure such as that called for in the claims *and* in which all of the support comes from the vessel within which the tower is operating."

Although the file history does contain certain remarks that stress base support means, we need not infer an intention that the remarks are exclusive. Those statements were made in an effort to describe the device and to distinguish the prior art generally, rather than to distinguish the prior art in terms of patentability. *See Kolene Co.* v. *Motor City Metal Treating, Inc.*, 440 F.2d 77 (6th Cir. 1971), *cert. denied*, 404 U.S. 886 (1971); *Schramm, Inc.* v. *Hinde*, 385 F.Supp. 1037 (N.D.Ill. 1974), *aff'd mem.*, 515 F.2d 511 (7th Cir. 1975), *aff'd mem.*, 539 F.2d 713 (7th Cir. 1976). Accordingly, we conclude that file wrapper estoppel will not save Fordees from infringement.

The judgment of the District Court is affirmed.

JOINER, District Judge. I dissent.

On the assumption that the prevailing law of res judicata and privity in this circuit prevents the defendant from challenging the validity of the patent at issue, I would nonetheless hold that the record does not support the finding of infringement and would reverse on this ground.

As a preliminary matter, I disagree with the majority opinion's crucial characterization of the teachings of the patent with regard to support means for the Titzel relining tower. Claim I of the patent teaches only one means of support, "base means on the lower portion adapted to engage the vessel bottom at spaced apart adjustable level points whereby the tower may be levelled and supported . . ." The second means of support relied on by the majority does not exist. The portion of the patent claim relied on refers to the supports for the working platform: "[A] plurality of support arms spaced about said carrier means and pivoted thereon from a position parallel to the lower portion of the tower to a position transverse to the tower means *to form a working platform*. . ." This aspect of the tower does not provide support for the tower itself, but is the means by which the *work platform* is supported.

Secondly, the majority states that plaintiff's exhibit 99 reveals that the tower is actually supported by a trunnion ring across its waist, which allows rotation around a pivot point. The record reflects, however, that the trunnion ring supports not the tower, but the vessel within which the tower is used.

The patent in this case describes a tower that is "normally free standing." The term "free standing" must be given content by the claims of the patent itself as well as its file history. As noted above, Claim I of the patent refers to only one means of support – the base means identified by the numeral 16 on the diagram appended to this opinion. Claim 2 describes a *temporary* support feature to be used for setting the tower, the feature identified by numerals 36 through 39 on the diagram appended to this opinion. It is clear, however, that

base means support is the key support feature of the patent, as is evident from the following history of the successive applications for the patent.

The initial application described a tower which had jack means at the bottom of the tower for supporting and positioning the tower. Additionally, the claims described outrigger members on the tower designed to bear on supporting members spaced from and about the tower. The outrigger members are now identified by numerals 36-39 in the current diagram of the patent. The patent office rejected the claim regarding base support means in view of the Laaback patent which taught a tower resting on one base support point. The application was then amended to stress that the base means were the primary support of the tower. However, references to the outriggers were retained. This application was also rejected, but not because of the claims relating to base support means. Rather, the outrigger feature was rejected in view of the Laaback patent which taught top support by way of a platform in conjunction with the base means identified above. Finally, the application was resubmitted, this time by a complete rewording of all the claims. The outrigger feature was relegated to providing temporary support for setting the tower. The only support means identified in Claim I was the base support means.

The remarks of the applicant's lawyer submitted in support of the second amended application give substance to the meaning of the term "free standing."

> [The claims] have been rewritten to bring out the fact that the tower is normally freestanding and *supported solely from* the base of the tower . . .
>
> The Laaback patent shows a vertical lift scaffold which is primarily supported at the top by the members 28 and 32 [the platform] acting in conjunction with a leveling device 46 [at the base]. Again there is no suggestion in Laaback of a tower structure such as that called for in

> the claims and in which all of the support *comes from the vessel within which the tower is operating.* [Emphasis supplied.]

It was based on these remarks that the patent examiner approved the final claims and issued the patent.

At trial, plaintiff's expert, Dr. James P. Romualdi, testified that the Titzel tower had three support means. He first identified the base support means. He then identified the support contributed by the platform identified by the numeral 30 when it is connected to the service floor, 31. Finally, he identified the outrigger supports, but stated that these supports are not essential when the base means and platform operate together. He stated that if the tower were supported only the base means it would not be stable and thus not free standing. However, when identifying the portions of the patent teaching support means, he pointed to no reference regarding the support derived from the platform when attached to the service floor. He could not have stated that the patent taught such support for it simply does not teach support by any means other than the base means and the temporary setting support derived from the outriggers. In fact the patent drawings show that the platform is not attached to the tower. Figure 1 of the diagrams appended to this opinion.

The record before this court indicates that the Titzel tower functions in a manner not described by the patent, and in a manner rejected by the patent office. However, the question before this court is not whether defendant's towers infringe plaintiff's towers as used, but whether they infringe plaintiff's patent. This they do not.

The district court found that the M&G and Fordees reline towers were primarily supported from the service floor. Both appellant and appellee agree that there is no difference between the first tower built by Fordees and subsequent towers built by it. The fact that the defendant's towers derived their

primary support from the service floor distinguishes its towers from plaintiff's patent, and precludes a finding of infringement. The patent teaches sole base means support, and the method of support utilized by the defendant is substantially different from that claimed in the patent, and is simply not the equivalent. The use of a means to support the tower from the service floor cannot be considered an equivalent because this means of support is described in the prior art (Laaback patent).

For these reasons, I would conclude that the district court's finding of infringement is not supported by the record, and reverse.

APPENDIX

Plaintiff's Exhibit 99

Jan. 19, 1965 J. M. TITZEL 3,166,154

PORTABLE SCAFFOLDS AND WORK TOWERS

FILED FEB 3, 1961 3 SHEETS-SHEET 1

Fig. 1.

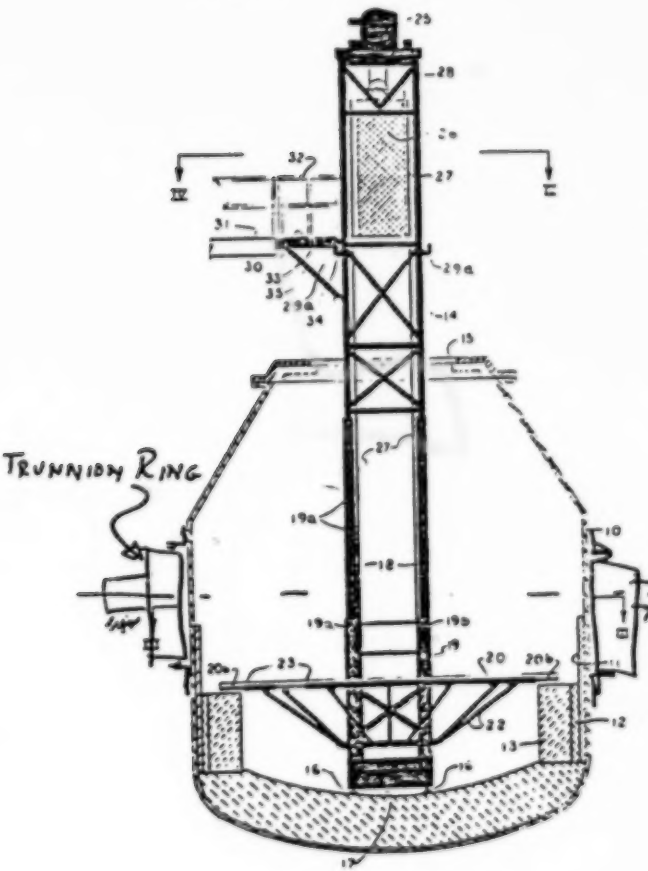
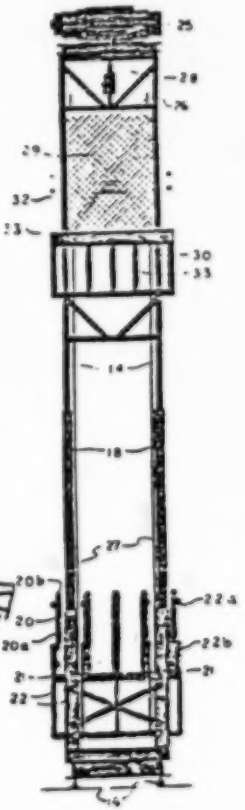


Fig. 2.



INVENTOR
JOHN M TITZEL

Plaintiff's Exhibit 100 2.

Jan. 19, 1965 J. M. TITZEL 3,166,154

PORTABLE SCAFFOLDS AND WORK TOWERS

FILED FEB. 2, 1962 3 SHEETS - SHEET 2

Fig. 3.

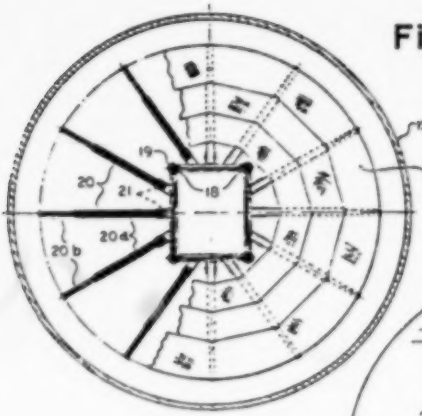
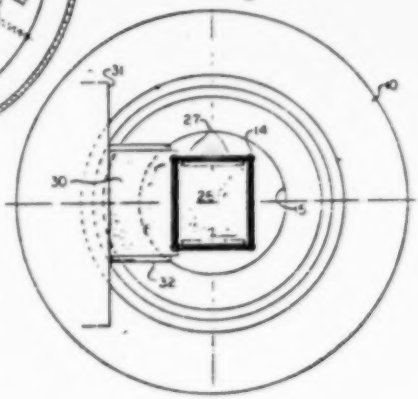


Fig. 4.



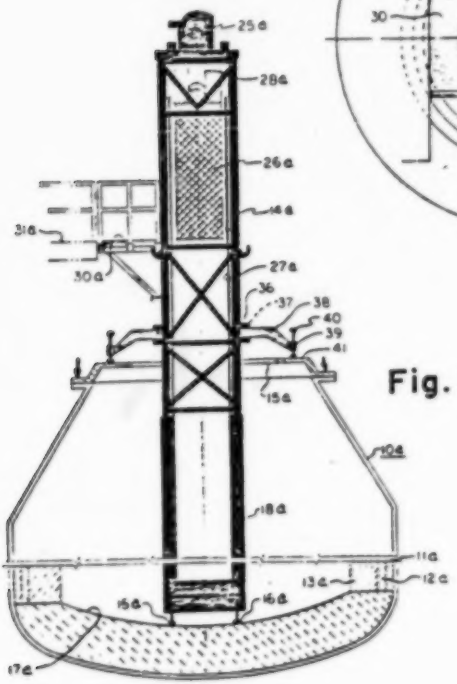


Fig. 5.

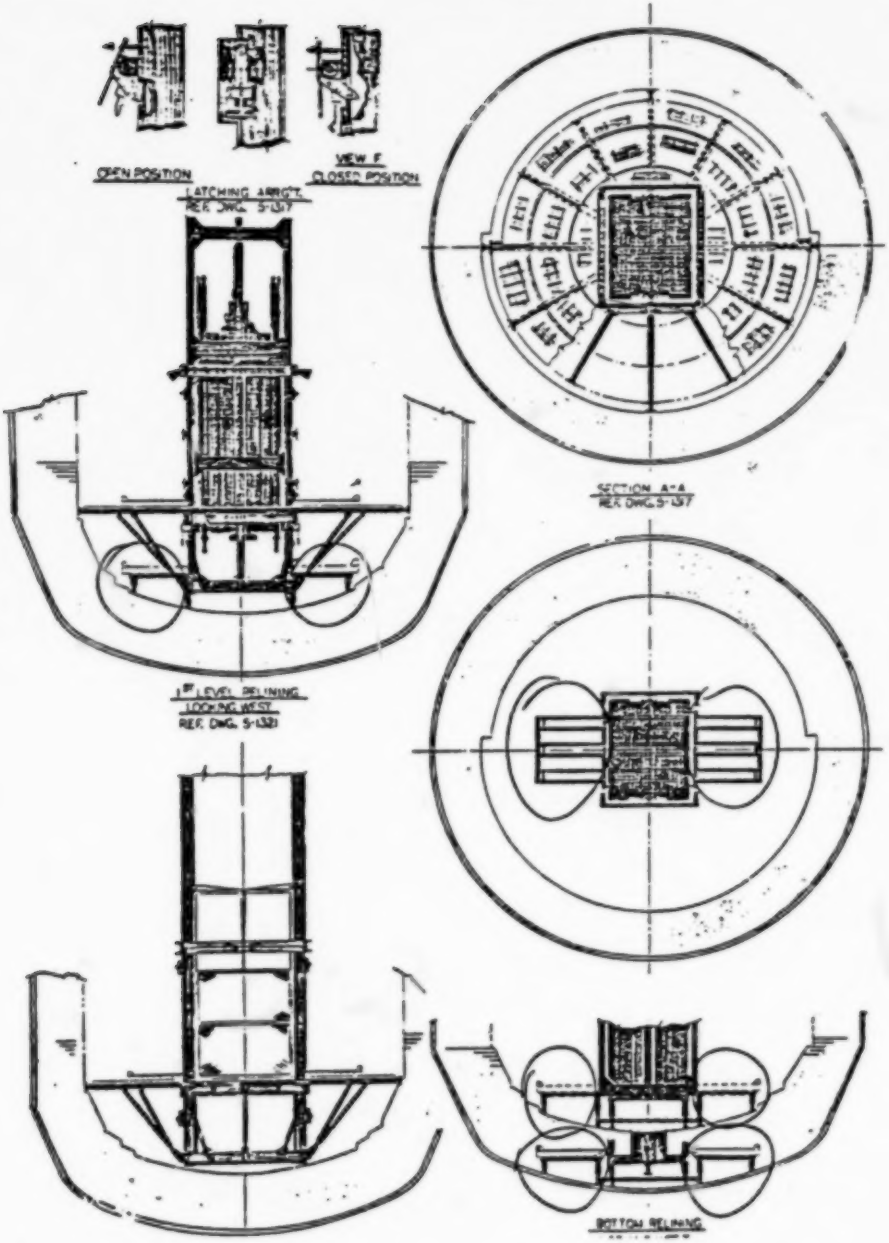
INVENTOR
JOHN M TITZEL

Plaintiff's Exhibit 101

3.

M & G RELINE TOWER

PURCHASED BY FORDEES

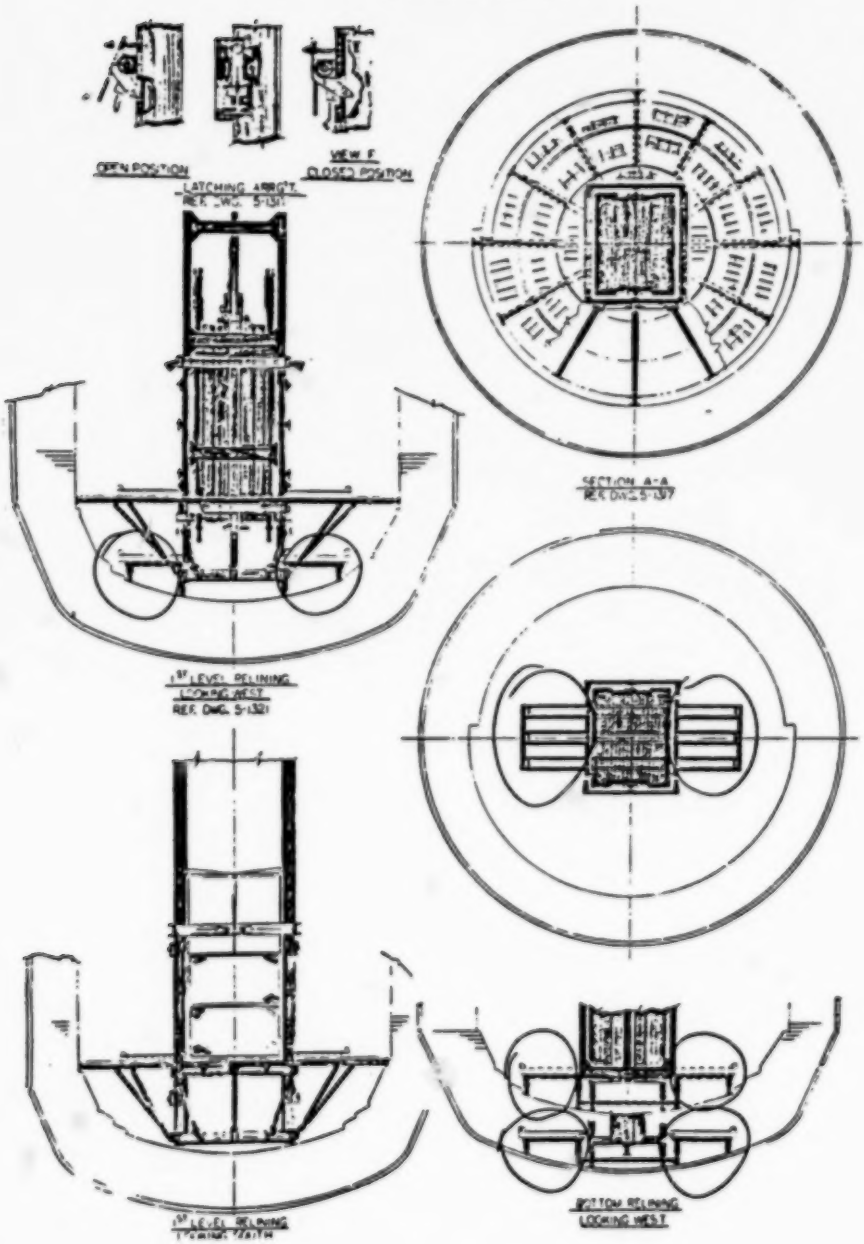


Plaintiff's Exhibit 102

M & G RELINE TOWER

PURCHASED BY FORDEES

4.

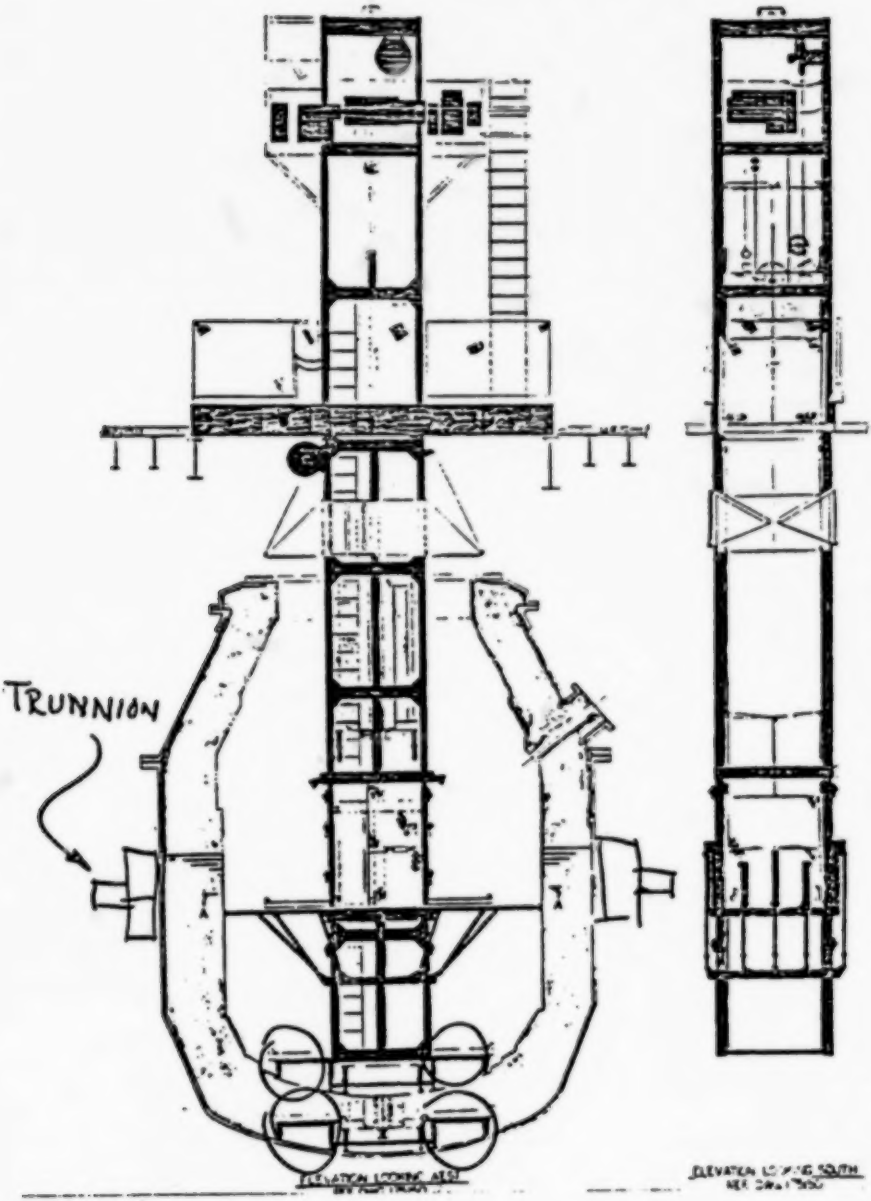


Plaintiff's Exhibit 103

5.

FORDEES 1st RELINE TOWER

U.S. STEEL GARY BOP SHOP No 2

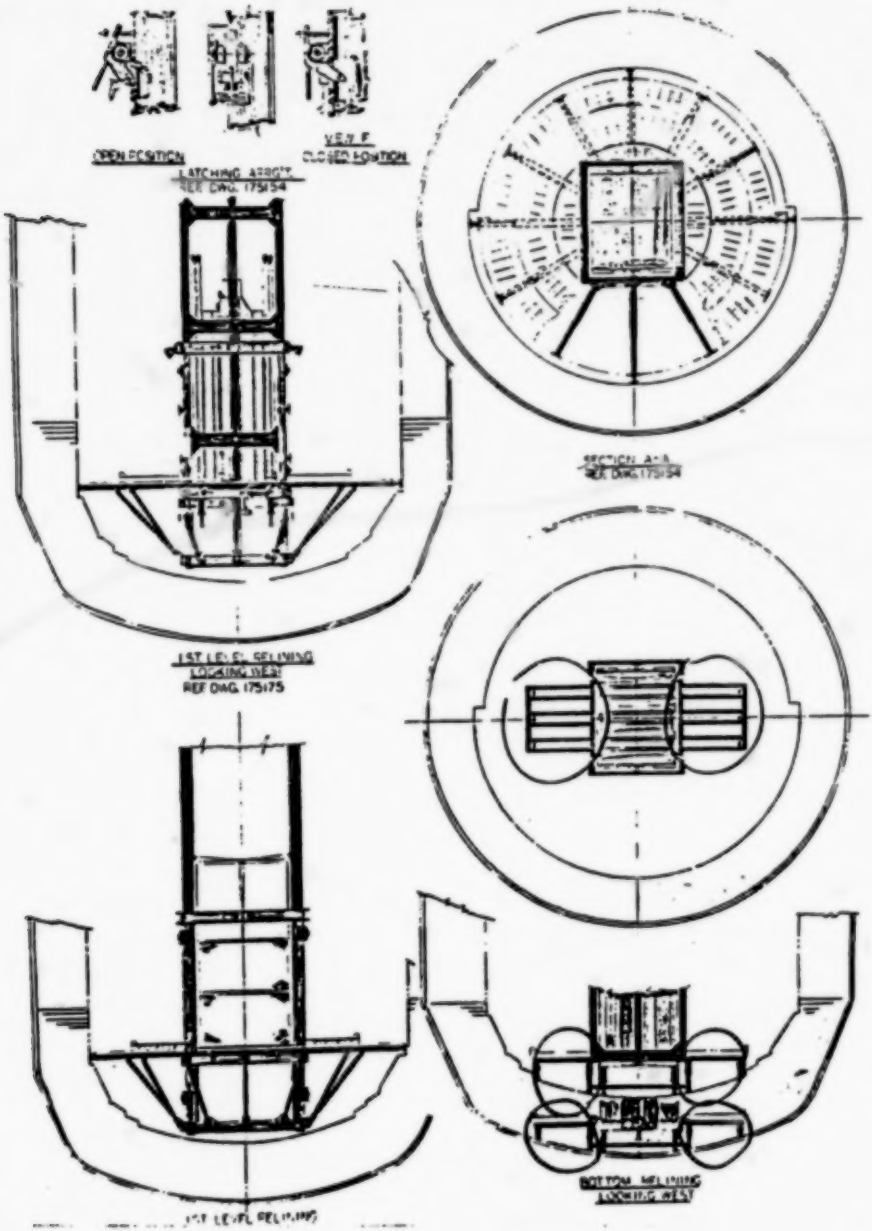


Plaintiff's Exhibit 104

FORDEES 1st RELINE TOWER

U. S. STEEL GARY BOP SHOP Nº2

6.

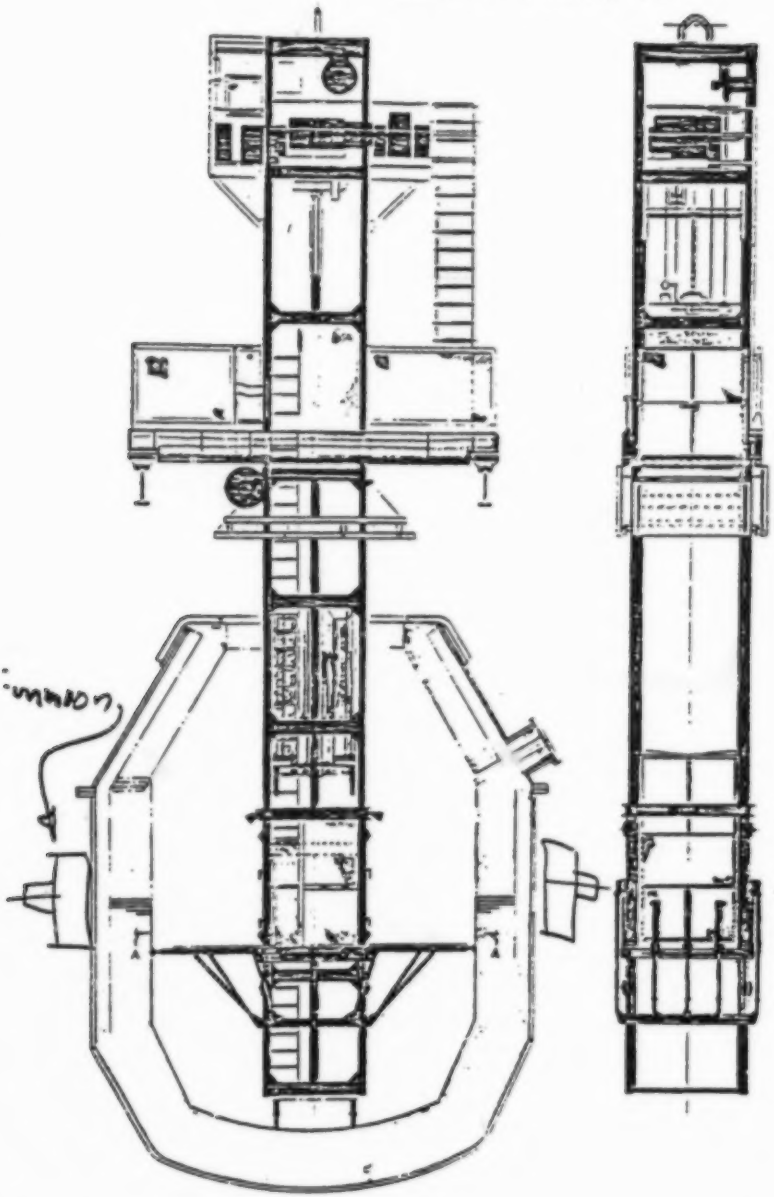


Plaintiff's Exhibit 105

7.

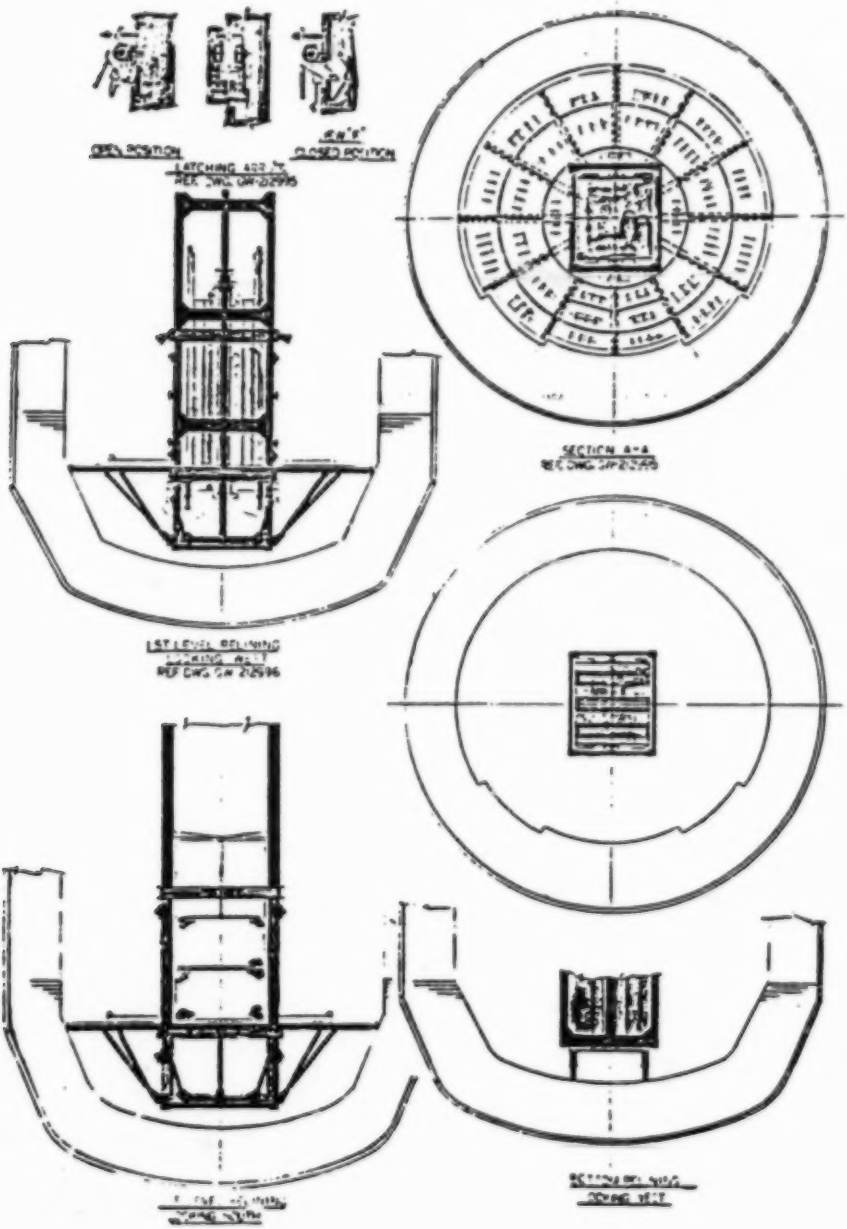
FORDEES 2nd RELINE TOWER

U.S. STEEL GARY BOP SHOP No 1



Plaintiff's Exhibit 106 **FORDEES 2nd RELINE TOWER**
U.S. STEEL GARY BOP SHOP N°1

8.



PLAINTIFF'S EXHIBIT NO. 1

Jan. 19, 1965 J. M. TITZEL 3,166,154

PORTABLE SCAFFOLDS AND WORK TOWERS

Filed Feb. 2, 1962 2 Sheets-Sheet 1

Fig. 1.

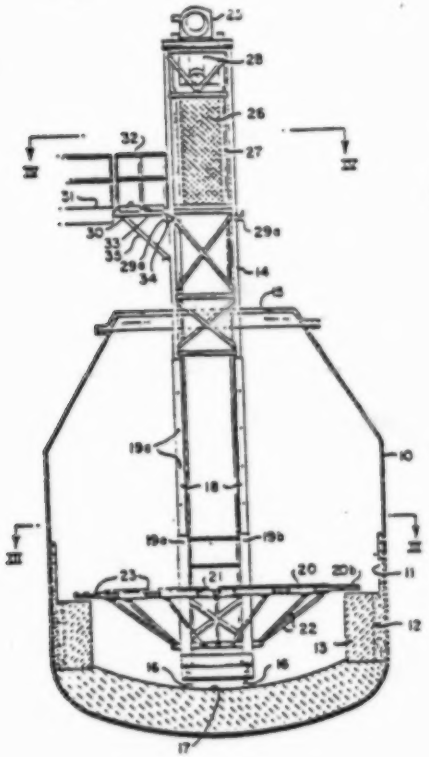
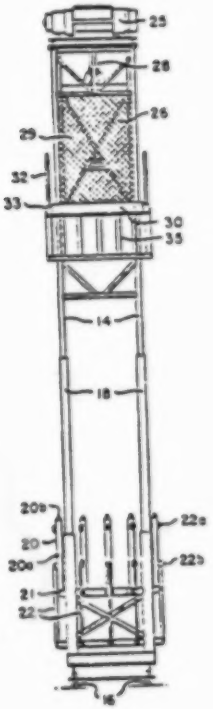


Fig. 2.



INVENTOR
John M Titzel

Jan. 19, 1965 J. M. TITZEL 3,166,154

PORTABLE SCAFFOLDS AND WORK TOWERS

Filed Feb. 2, 1962 2 Sheets-Sheet 2

Fig. 3.

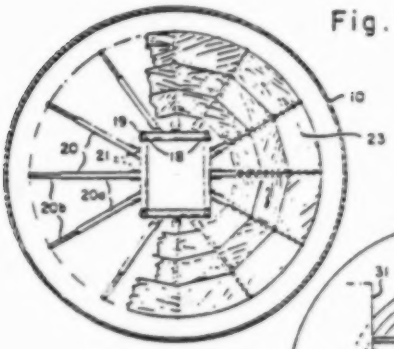
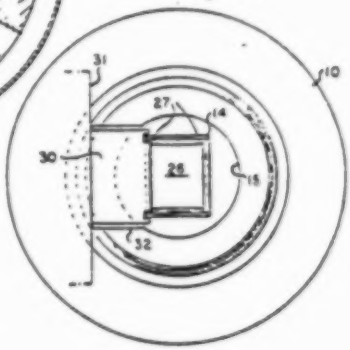


Fig. 4.



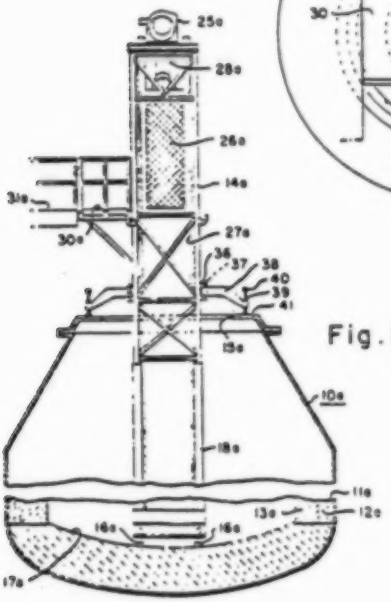


Fig. 5.

INVENTOR
John M. Titzel

APPEAL NO. 318 96

170747 SERIAL NO. (Series of 1948)	P. R. Div.		PATENT NUMBER 3166154
Assistant examiner	Class /	Subclass	DATED JAN 19 1965
Division No. A 420(61)	Filed complete (Date) FEB. 2, 1962	Serial No. 170 747	CLAIMS FOREIGN PRIORITY Country: None Date

DX-2

Applicant(s)

TITZEL, JOHN M. OF FOX CHAPEL, PA.

Number claims allowed	Print claim(s)	Class	Subclass
4	1	182	128

Assignor to Titzel Engineering Inc., Pittsburgh, Pa.

Title of invention

PORTABLE SCAFFOLDS AND WORK TOWERS

☐ Division of ☐ Continuation of ☐ Substitute for abandoned — none — APPLICATION Serial No. Filed

☐ Continuation-in-part of — none — APPLICATION Serial No. Filed

Sh. drw.	Extra claims	Filing fee	Transaction	Atty's docket
2		$30	93588	

Now Patent No. Granted

Send correspondence to:

HOOPES, LEONARD & BUELL
1519 FARMERS BANK BLDG.,
PITTSBURGH 22, PA.

Principal attorney(s)

HOOPES, LEONARD & BUELL 2/23/62 562

Associate attorney(s)

PARTS OF APPLICATION FILED SEPARATELY

PREPARED FOR ISSUE

R. Machado A. Turner
(Assistant Examiner) (Docket Clerk)

EXAMINED AND PASSED FOR ISSUE

H.R. Moseley JUN 4 1964 428
(Primary Examiner) (Division)

NOTICE OF ALLOWANCE MAILED

JUN 12 1964

[THIS SPACE RESERVED FOR RETENTION LABEL]

[THIS SPACE RESERVED]

FINAL FEE

Date	Amount
NOV 21 1964	$30.00

Bill's Expedition Pub. Inc. No. 2

170747
318 96
APPEAL NO

2-23-62

241-74-11

15.66-26-1

CONTENTS

1. Application _____ papers.
2. Print
3. REJECTION SEP 24 1962
4. Amdt. Mar 25 1963
5. Brief to Issue-Jun 6, 1963
6. Final Rejection OCT 30 1933
7. APPEAL NO. 318 96 Aug. 29, 1964
8. Amdt. & Rel May 6, 1969
9. LIST OF REFERENCES
10. Notice of Suit Nov. 23, 1970
11. Notice of Suit (Decided) Oct. 15, 1971
12. _____
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170747

SERIAL NO. (Series of 1948)

Assistant examiner

Division No.

B 43

Applicant

FINAL

INDEX OF CLAIMS

Claim	Date			Claim	Date
Final	Original	9 7 62	10 8 63	5 22 64	Final	Original	
		✓	✓				
		2	✓				
		3	✓				
		4	✓				
		5	✓				
		6	✓				
		7	✓				
		8	✓				
1		10					
2		11					
3		12					
4		13					

SEARCHED

Class	Sub	Date	Ex'r
182	128	9-7-62	RPM
	145		
	146		
	141		
	150		
	129		
	206		
	214		
	187		
187	2		
	9		
	11		
50	536	10/7/63	RPM
182	142		
	↓		
	147		

INTERFERENCE SEARCHED

CLASS	SUB.	DATE	EX'R
182	128	5/22/64	RPM
	145		
	142		

SYMBOLS	STATUS
/	Rejected
*	Allowed
– (Through numeral)	Cancelled
+	Restriction requirement
N	Non-elected invention or species
I	Interference
A	Appeal

4. A portable work tower as claimed in claim 3 wherein elevator means are provided within the tower movable longitudinally thereof independently of the carrier means.

5. A portable work tower particularly adapted for use in vessels having an opening smaller than the interior diameter comprising an elongated tower means adapted to pass through the opening in said vessel, guide means on the periphery of the tower longitudinally thereof, carrier means movable on said guide means, support arms pivoted at one end on said carrier means from a position parallel to the tower means to a position transverse to the tower means to form a platform support, lift means on the tower selectively raising and lowering the carrier means, outrigger members on said tower intermediate the ends thereof extending transversely outwardly from the periphery and jack means on said outrigger members adapted to bear on a supporting member spaced from and surrounding the tower.

6. A portable work tower as claimed in claim 5 wherein elevator means are provided within the tower movable longitudinally thereof independently of the carrier means and said outrigger members are removably pivoted on the tower.

7. A portable work tower particularly adapted for use in vessels having an opening smaller than the interior diameter comprising an elongated tower means of quadrangular section adapted to pass through the opening in said vessel, guide means on the corners of the tower longitudinally thereof over the length of tower within the vessel, carrier means movable on said guide means and surrounding the tower, support arms spaced about the tower pivoted at one end on

said carrier means from a position parallel to the tower means to a position transverse to the tower means to form a platform support, removable platform means on said support arms in the transverse position, lift means on the tower selectively raising and lowering the carrier means, outrigger members on said tower at each corner above the guide means extending transversely outwardly therefrom and jack means on said outrigger member adapted to bear on a supporting member spaced from and about the tower.

8. A portable work tower as claimed in claim 7 wherein elevator means are provided within the tower movable longitudinally thereof independently of the carrier means.

9. A portable work tower as claimed in claim 7 wherein the bottom of the tower is provided with jack means for supporting and positioning the tower.

add (3)

I claim:

1. A portable work tower particularly adapted for use in vessels having an opening smaller than the interior diameter comprising an elongated tower means adapted to pass through the opening in said vessel, guide means on the periphery of the tower longitudinally thereof, carrier means movable on said guide means, support arms pivoted at one end on said carrier means from a position parallel to the tower means to a position transverse to the tower means to form a platform support, lift means on the tower selectively raising and lowering the carrier means.

2. A portable work tower as claimed in claim 1 wherein elevator means are provided within the tower movable longitudinally thereof independently of the carrier means.

3. A portable work tower particularly adapted for use in vessels having an opening smaller than the interior diameter comprising an elongated tower means of quadrangular section adapted to pass through the opening in said vessel, guide means on the corners of the tower longitudinally thereof, carrier means surrounding the tower and movable on said guide means, a plurality of support arms spaced about said carrier means and pivoted at one end on said carrier means from a position parallel to the tower means to a position transverse to the tower means to form a platform support, lift means on the tower selectively raising and lowering the carrier means with respect to the tower and adjustable jack means on the bottom of the tower for positioning said tower vertically.

Oath, Power of Attorney and Petition

Being duly sworn, I, JOHN M. TITZEL

depose and say that I am a citizen of the United States of America residing at Fox Chapel, County of Allegheny, Commonwealth of Pennsylvania, that my post-office address is c/o Titzel Engineering Inc., 260 42nd Street, Pittsburgh, Pennsylvania, that I have read the foregoing specification, including the claims, and verily believe myself to be the original, first and sole inventor of the invention or discovery in PORTABLE SCAFFOLDS AND WORK TOWERS

described and claimed therein; that I do not know and do not believe that the same was ever known or used before my invention or discovery thereof, or patented or described in any printed publication in any country before my invention or discovery thereof or more than one year prior to this application, or in public use or on sale in the United States of America more than one year prior to this application; and that no application for patent thereon has been filed by me or my legal representatives or assigns in any country foreign to the United States of America.

I hereby appoint the firm of Hoopes, Leonard & Buell (whose members are Edward Hoopes III, John H. F. Leonard, Eugene F. Buell, Walter J. Blenko, Jr., and Frederick B. Ziesenheim) of Pittsburgh, Pennsylvania, whose postoffice address is 1319 Farmers Bank Building, Pittsburgh 22, Pennsylvania, my attorneys, with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent Office connected therewith, to sign the drawings, to amend the specification, to appeal in case of rejection, as they may deem advisable, to receive the patent when granted and generally to do all matters and things needful in the premises, as fully and to all intents and purposes as I could do.

I pray that Letters Patent of the United States of America be granted to me for the invention or discovery described and claimed in the foregoing specification, and I hereby subscribe my name to the foregoing specification, oath and power of attorney and this petition this 7th day of February 19 62.

Inventor John M. Titzel

State of Pennsylvania }
County of Allegheny } ss.

Before me personally appeared JOHN M. TITZEL to me known to be the person described in the foregoing application for patent, who signed the same in my presence and made oath before me to the allegations set forth therein as being under oath on the day and year aforesaid.

Charles E Bauer
Notary Public

[NOTARIAL SEAL]

This form to be attached to a complete application as the last page thereof.

SOLE INVENTOR

9

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON

Paper No. 3

Hoopes, Leonard & Buell
1319 Farmers Bank Bldg.
Pittsburgh 22, Pennsylvania

Applicant: John H. Titzel	
Ser. No. 170,717	
Filed February 2, 1962	SEP
For PORTABLE SCAFFOLDS AND WORK TOWERS	PA DIV

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

This application has been examined.

References cited:

Nadot (France	1,181,529 2 shts. dwg., 3 pp. spec.)	Jan. 12, 1959	182-128
Myers	1,380,074	May 31, 1921	182-128
Lasback	2,563,682	Aug. 7, 1951	182-229
Arnold	2,933,918	Apr. 26, 1960	182-128
Abarotin	3,033,389 (filed	May 8, 1962 Sept. 26, 1960)	182-128

Claims 1, 5 and 7 are rejected as unpatentable over Nadot in view of Myers. To pivotally connect the arms 13-20 of Nadot's scaffold to the carrier, would not be considered patentable in view of Myers at 10 and 11. As shown by Fig. 9a of Nadot, the outriggers 10 engage the tower at its upper end, merely to provide leveling jacks on said outriggers would not be considered a patentable distinction.

Claims 2 and 8 are rejected as unpatentable over the same references as applied against claim 1 in view of the teaching of Arnold or Abarotin. To provide elevator means within the tower of Nadot, would be considered unpatent-

able in view of Arnold at 47 or Abarotin at 28.

Claims 3 and 9 are rejected as unpatentable over the same references as applied against claim 1 in view of Laaback. To further provide Nadot's scaffolding frame with leveling means would be considered obvious and unpatentable in view of Laaback at 46.

Claims 4 and 6 are rejected as unpatentable over the same references as applied against claim 3 in view of the teaching of Arnold or Abarotin as applied against claim 2.

All the claims are rejected.

R.P. Machado:lmb

Examiner

EFB/rl

RECEIVED
MAR 28 1963
GROUP 450

IN THE UNITED STATES PATENT OFFICE

Division 8 :
In re application of :
JOHN M. TITZEL : PORTABLE SCAFFOLDS AND WORK TOWERS
Serial No. 170,747 :
Filed February 2, 1962 :

A M E N D M E N T

Pittsburgh, Pennsylvania
March 22, 1963

Hon. Commissioner of Patents
Washington, D. C.

Sir:

In response to the Official Action of September 24, 1962, please amend this application as follows:

Claim 1, line 4, after "vessel," add --adjustably positionable base means on the tower adapted to engage the vessel bottom and provide support for the tower--.

Claim 3, line 4, after "vessel," add --adjustably positionable base means on the tower adapted to engage the vessel bottom and provide support for the tower--; line 13, change "bottom" to --base means--; same line, before "positioning" add --adjustably--.

Claim 5, line 4, after "vessel," add --adjustably positionable base means on the tower adapted to engage the vessel bottom and provide support for the tower--.

Claim 7, line 4, after "vessel," add --adjustably positionable base means on the tower adapted to engage the

vessel bottom and provide support for the tower.

Remarks

The applicant has carefully reviewed the application and the several cited references and has amended the claims to more clearly bring out the significant distinctions between the present invention and the cited references.

The present invention is directed to a portable scaffold and work tower structure in which the structure is supported from the bottom of the vessel in which the work is being carried out. This eliminates the need for overhead support members and for immobilization of a crane or other like device holding the tower in the vertical position. None of the prior art provides such a structure.

Reconsideration of the rejection of claims 1, 5 and 7 as unpatentable over Nadot in view of Myers is requested. In the Nadot structure, the work device is supported at all times from a gantry assembly and is completely dependent upon the gantry for its support. Moreover, in order to move the assembly, it must be disassembled, piece by piece, and reassembled into its new position, piece by piece. All of this is eliminated in the present invention. The unit may be removed as a complete unit or it may be disassembled. It may be placed in the vessel and is supported entirely by the vessel in which the work is progressing without any need for a supporting crane or gantry structure, or the like.

The Myers device does not correct this deficiency of the primary reference because Myers shows nothing but a single pole on which a hollow cylindrical member 4 is slidable. This device is not the equivalent of that called for

by the claims and it would not suggest to men skilled in the art any modification of Nadot to correct the Nadot deficiencies. Myers is supported at the top and against the sidewalls of the silo in which it is used. No such supports are necessary in the present invention.

Reconsideration of the rejection of claims 2 and 8 as unpatentable over the same references in view of Arnold or Abarotin is requested. Neither Arnold nor Abarotin correct the deficiencies of the primary reference discussed above. Both require a separate supporting device. Abarotin is supported on a crane hook and all operations are carried out with the device suspended from the hook. The Arnold patent shows a deck 28 mounted on beams 29 constructed by welding to the bosh of the furnace and all operations are carried out suspended from or supported from this deck. All of this is eliminated by the present invention.

Reconsideration of the rejection of claims 3 and 9 as unpatentable over the same references in view of Laaback is requested. The Laaback patent shows a vertical lift scaffold which is primarily supported at the top by the members 28 and 32 acting in conjunction with a leveling device 46. Again, there is no suggestion in Laaback of a tower structure such as that called for in the claims and in which all of the support comes from the vessel within which the tower is operating.

Reconsideration of the rejection of claims 4 and 5 as unpatentable over the same references as applied against claim 3 in view of the teaching of Arnold or Abarotin is requested. Again, the secondary references fail to teach the necessary modification of the primary references to

overcome the problem which the present invention solves, namely that of supporting the lower device from the top. All of the prior art structures cited have the common drawback that their support is not from the bottom and not from within the vessel but from some overhead crane or gantry or semi-permanent beam construction. Applicant's device is the first to provide its major support from the bottom and eliminate entirely all top support.

In view of the important distinctions pointed out herein, it is submitted that this application is patentable over the references. Favorable reconsideration and allowance are respectfully solicited.

Respectfully submitted,

Attorneys for Applicant

In re: JOHN McCORMICK TITZEL

Title: Portable Scaffolds and Work Towers

Serial No. 170,747

Filed February 2,1962

Div. 8

Hon. Commissioner of Patents

Washington, D.C.

Sir:

Please permit Messrs. Langner, Parry, Card & Langner, or their representatives, to inspect the above entitled application, and to make copies of any of the papers that they may desire.

Respectfully,

/s/ Leonard S. Buell

(Attorney of Record)

by Eugene S. Buell

APPROVED

JUN 1: 1963

/s/ Lawrence

DOCUMENT SERVICES BRANCH

Form No. 6

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON

In Reply Please Refer To: Group 420

Hoopes, Leonard & Buell
1319 Farmers Bank Bldg.
Pittsburgh 22, Pa.

Applicant: John M. Titzel	MAILED
Ser. No. 170,747	OCT 30 1963
Filed Feb. 2, 1962	GROUP 420
For PORTABLE SCAFFOLDS AND WORK TOWERS	

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

Responsive to amendment filed March 25, 1963.

Claims 1, 3, 5, 7 and 9 are now rejected as failing to define patentably over Laaback in view of Myers both of record. To make the support arms and platform means of Laaback foldable, would be considered unpatentable in view of Myers. To use Laaback's scaffold inside a vessel would be considered a matter of choice only, furthermore the patent to Myers shows it is old to use a portable scaffold inside a vessel which teaching could also be applied to Laaback. The outrigger or support 28 shown by Laaback could be made removable pivoted and also multiplied in number if so desired and would be considered unpatentable.

Claims 2, 4, 6 and 8 are rejected as unpatentable over the same references as applied against claim 1 in view of Arnold. To provide Laaback's scaffold with elevator means would be obvious and unpatentable in view of the teaching of Arnold.

Applicant's attention is called to Rule 83 wherein it is stated that every feature claimed must be shown by the drawing. The "lift means on the tower selectively raising and lowering the carrier means" as claimed in claim 1, is only partially shown, since the hook on the carrier 19 which

is engaged by a latch on the elevator 26 and forming part of said lift means, have been omitted from the drawing. If the elevator is not connected to the carrier then there is no means for raising and lowering said carrier since the motor 25 is shown connected to the elevator only.

All the claims are rejected.

This action is made Final.

Although the references have been applied somewhat differently than before, final action at this time is not premature. See ex parte Hoogendam, 1939 C.D. 3.

R.P.Machado:dlc

H.R.Moseley
Examiner

EFD/rl

318 96

IN THE UNITED STATES PATENT OFFICE

BEFORE THE BOARD OF APPEALS

Group 420	:	
In re application of	:	
JOHN H. TITZEL	:	PORTABLE SCAFFOLDS AND WORK TOWERS
Serial No. 170,747	:	
Filed February 2, 1962	:	

APPEAL TO THE BOARD OF APPEALS

To the Commissioner of Patents:

Applicant hereby appeals to the Board of Appeals from the decision of the Principal Examiner finally rejecting claims 1-9.

The appeal fee of twenty-five dollars is filed herewith.

An oral hearing is requested.

Respectfully submitted,

/s/ George F. Bucknell

Attorneys for Applicant

Pittsburgh, Pennsylvania

April 21, 1964

EFB/rl

7387

IN THE UNITED STATES PATENT OFFICE

RECEIVED
MAY 6 1964
GROUP 420

Group 420 :

In re application of :

JOHN M. TITZEL :

Serial No. 170,747 :

Filed February 2, 1962 :

PORTABLE SCAFFOLDS AND WORK TOWERS

MAY 19 1964
U.S. PATENT OFFICE

AMENDMENT

Pittsburgh, Pennsylvania

May 4, 1964

Hon. Commissioner of Patents

Washington, D. C.

Sir:

In response to the Official Action of October 30, 1963, and confirming the oral interviews kindly granted to applicant's attorneys on April 29th and 30th, please amend this application as follows:

Cancel all the claims.

Add the following new claims:

1-10. A portable work tower particularly adapted for use in vessels having an opening smaller than the interior comprising an elongated tower means adapted to pass through the opening in said vessel and be normally free standing, said tower means including upper and lower portions having spaced apart vertically extending members at the corners of a quadrangle, said vertically extending members on the lower portion being provided with carrier means vertically movable thereon, base means on the lower portion adapted to engage

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the vessel bottom at spaced apart adjustable level points whereby the tower may be levelled and supported, a plurality of support arms spaced about said carrier means and pivoted thereon from a position parallel to the lower portion of the tower to a position transverse to the tower means to form a working platform, spaced cage guides within the upper and lower portions forming an inner cage guide extending from adjacent one end of the tower to the opposite end of said tower, cage means vertically movable on said cage guides within the upper and lower tower portions and lift means on the tower means selectively raising and lowering the cage means, said cage means being selectively coupled with said carrier means for raising and lowering said carrier means with said cage means.

2 --~~11~~. A portable work tower as claimed in claim ~~10~~ 1 wherein the tower means is provided with removable outriggers extending transversely outwardly from the tower intermediate the ends thereof and terminating in free ends, jack means carried by said free ends adapted to bear on a supporting surface spaced from and surrounding the tower to provide temporary support for setting the tower.

3 --~~12~~. A portable work tower as claimed in claim ~~10~~ 1 wherein the carrier means is formed of generally annular members surrounding and slidable on the vertically extending members of the lower tower portion, said members being connected together to form a unitary vertically movable cage.

4 --~~13~~. A portable work tower as claimed in claim ~~12~~ 3 wherein the annular members of the carrier means and the vertically extending members of the lower tower portion are provided with mating openings adapted to receive locking pins to hold the carrier at a given level.

Remarks

The applicant has rewritten the claims and reduced them in number as discussed with the Examiner in the interviews kindly granted to the applicant's attorneys on April 29 and 30, 1964. The courtesy of these interviews and the suggestions and recommendations made by the Examiner are appreciated.

The claims have been rewritten to bring out fundamental differences between the portable work tower of the present application and the devices of the prior art. They have been rewritten to bring out the fact that the tower is normally freestanding and supported solely from the base of the tower and is provided with an inner moving cage and an outer carrier means. This permits workmen to work on the platform supported on the movable carrier means while materials are delivered to them from the interior of the tower by means of the moving cage. This is a new concept in portable scaffolds and work towers and is completely different from the prior art. It eliminates the need for overhead support members and for immobilization of the crane or other like device holding the tower in vertical position. We shall deal with the several references and point out the significant differences.

In the Nadot structure, the work device is supported at all times from a gantry assembly and is completely dependent upon the gantry for its support. Moreover, in order to move the assembly, it must be disassembled, piece by piece, and reassembled into its new position, piece by piece. All of this is eliminated in the present invention. The unit may be removed as a complete unit or it may be disassembled.

It may be placed in the vessel and is supported entirely by the vessel in which the work is progressing without any need for a supporting crane or gantry structure, or the like. Moreover, Nadot does not show any outer carrier means and inner independently moving cage means.

Myers shows nothing but a single pole on which a hollow cylindrical member 4 is slidable. This device is not the equivalent of that called for by the claims and it would not suggest to men skilled in the art any modification of Nadot to correct the Nadot deficiencies. Myers is supported at the top and against the sidewalls of the silo in which it is used. No such supports are necessary in the present invention.

Abarotin is supported on a crane hook and all operations are carried out with the device suspended from the hook. The Arnold patent shows a deck 28 mounted on beams 29 constructed by welding to the bosh of the furnace and all operations are carried out suspended from or supported from this deck. All of this is eliminated by the present invention.

The Laaback patent shows a vertical lift scaffold which is primarily supported at the top by the members 28 and 32 acting in conjunction with a leveling device 46. Again, there is no suggestion in Laaback of a tower structure such as that called for in the claims and in which all of the support comes from the vessel within which the tower is operating.

Further, and significantly, none of the prior art shows a structure in which a quadrangular tower means is

provided having upper and lower portions with spaced apart vertically extending members and being provided with a carrier means vertically movable outside this tower on the lower portion thereof and an inner cage movable within both the upper and lower portions independently of the carrier means.

Reconsideration and allowance of this application are respectfully solicited.

Respectfully submitted,

Attorneys for Applicant

Paper No.: 7389

Serial No.: 170,747

REFERENCES CITED

The following references are of record in the patented file of this patent:

UNITED STATES PATENTS

Name	Number	Date
Myers	1,380,074	May 31, 1921
Lanback	2,563,682	Aug. 7, 1951
Arnold	2,933,918	Apr. 26, 1960
Abarotin	3,033,389	May 8, 1962

FOREIGN PATENTS

Country	Number	Date
France	1,181,529	Jan. 12, 1959

OTHER REFERENCES

POL.-85
(6-62)

ADDRESS ONLY
THE COMMISSIONER OF PATENTS
WASHINGTON, D. C. 20231

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON

All communications concerning this application should give the serial number, date of filing, and name of the applicant.

NOTICE OF ALLOWANCE

The application for patent identified below has been examined and found allowable for issuance of Letters Patent.

	FILING DATE	SERIAL NO.	NO. OF CLAIMS ALLOWED	EXAMINER	GROUP
	02/02/62	170747	4	H. R. Moseley	42
APPLICANT	Titzel, John M., Fox Chapel, Pa.			MAILED JUNE 12, 1964	
ASSIGNEE	Titzel Engineering Inc.				
TITLE OF INVENTION	Portable scaffolds and work towers			CLASS-SUB	182/128

With the allowance of the application the final fee becomes due. This fee is thirty dollars ($30) plus one dollar ($1) for each claim allowed in excess of twenty (20) and must be paid within 6 months from the date of this notice. Failure to remit the final fee will result in the patent being withheld from issue.

As a convenience in remitting this fee, use of the enclosed Form POL-85a is suggested. The final fee will not be received from anyone other than the applicant, his assignee or attorney, or a party in interest as shown by the records of the Patent Office. If no entry appears in the space labeled "assignee," above, a form is enclosed relating to the address of the inventor(s) which requires your attention.

If it is desired to have the patent issued to an assignee or assignees, an assignment, together with the fee for recording the same, must be filed in this Office on or before the date of payment of the final fee.

The patent will be issued and forwarded within approximately two months after receipt of the final fee.

By direction of the Commissioner.

Noopes, Leonard, et al
1319 Farmers Bank Bldg.
Pittsburgh 22, Pa.

U. S. Department of Commerce
Patent Office

NOV 25

FINAL FEE TRANSMITTAL

provided for convenience in communicating final fees to the Patent Office. When properly completed it may be used in lieu of [illegible] transmittal letter. Respondent will enter and fill in items numbered 1 thru 6 below. The Final Fee Receipt, to be mailed to the address appearing on line at lower left of this form. If desired, use the reverse side of your Notice of Allowance for a return copy when completing this form.

1. THE COMMISSIONER OF PATENTS is requested to apply the accompanying fee to the case identified below, and deliver the patent as indicated.

November 25, 1964 — Hoopes, Leonard & Beecher
Date — Attorney, Agent or Applicant

NOTE—Final fees will not be received from other than the applicant, his assignee, or attorney, or a party in interest as shown by the records of the Patent Office. Final fees will not be applied to pending applications.

	FILING DATE	SERIAL NO.	NO. OF CLAIMS ALLOWED	EXAMINER	GROUP
	02/02/62	170747	4	H. R. Moseley	42
APPLICANT	Titsel, John M., Fox Chapel, Pa.				
ASSIGNEE	Titsel Engineering Inc.			MAILED JUNE 12, 1964	
TITLE OF INVENTION	Portable scaffolds and work towers			NOTICE OF ALLOWANCE DATE	
				CLASS-SUB	
				182/128	

2. DEFERMENT: (Indicate below if desired)	3. FEE ENCLOSED
[illegible]	$ 30.00
4. Assignee: (If assigned and name does not appear in the corresponding space above)	

MAILING INSTRUCTIONS

Note—The office will send the patent to the address covered in stub at left below unless you direct otherwise. Use the spaces provided to indicate any changes which affect the delivery of the patent.

5. Do not send the patent to the addressee listed below. Send patent to (check one)

- ☐ Patentee
- ☐ Assignee
- ☐ Associate Attorney (See specific authorization in file)
- ☐ Change of address—Attorney

The address of the person checked above is typed in Item 6 below.

6.

AO Form 150 (Rev. Oct. 1964) — In Re Patents

United States District Court

for the

WESTERN DISTRICT OF PENNSYLVANIA

SOLICITOR

NOV 25 1970

U.S. PATENT OFFICE

COMMISSIONER OF PATENTS,
Washington 25, D. C.

Pittsburgh

SIR:

In compliance with the Act of July 19, 1952 (66 Stat. 814; 35 USC 290), you are advised that there was filed on the 23rd day of November, 1970, in this court an action, No. 70-1333, entitled:

Name Titzel Engineering Co., Inc., Plaintiff,

Address 260 Forty-Second Street, Pittsburgh, Pennsylvania

versus

Name M & G Industrial Associates, Inc. and Robert N. Monroe, Defendant,

Address (Both) 7219 McKnight Road, Pittsburgh, Pennsylvania 15237

brought upon the following patents:

	PATENT NO.	DATE OF PATENT	PATENTEE
1	3,166,154	Jan. 19, 1965	John N. Titzel
2			
3			
4			
5			

In the above-entitled case, on the day of , 19 , the following patents have been included by (insert amendment, answer, cross bill, or other pleading):

	PATENT NO.	DATE OF PATENT	PATENTEE
1			
2			
3			
4			
5			

In the above-entitled case the following decision has been rendered or judgment issued:

JAMES N. WALLACE, JR.,
Clerk.

Date November 23, 19 70.

By Victoria L. Gibson
Deputy Clerk.

AO Form 120 (Rev. Oct. 1966)

In Re Patents

United States District Court

for the

WESTERN DISTRICT OF PENNSYLVANIA

#11

COMMISSIONER OF PATENTS,
Washington 25, D. C.

Sir:

In compliance with the Act of July 19, 1952 (66 Stat. 814; 35 USC 290), you are advised that there was filed on the 23rd day of November, 19 70, in this court an action, No. 70-1333, entitled:

Name TITZEL ENGINEERING CO., INC., Plaintiff,

Address

versus

Name M & G INDUSTRIAL ASSOCIATES INC., and ROBERT N. MUNROE, Defendant, s

Address

brought upon the following patents:

	PATENT NO.	DATE OF PATENT	PATENTEE
1	3,166,154		
2			
3			
4			
5			

In the above-entitled case, on the day of , 19 , the following patents have been included by (insert amendment, answer, cross bill, or other pleading):

	PATENT NO.	DATE OF PATENT	PATENTEE
1			
2			
3			
4			
5			

In the above-entitled case the following ~~decision was rendered or~~ judgment issued:
Defts' infringed upon letters patent No. 3,166,154

GENEVIEVE M. BARR
Clerk.

Date October 15, 1971, 19

By
Deputy Clerk.

No. 78-3325

UNITED STATES COURT OF APPEALS

FOR THE SIXTH CIRCUIT

FILED

OCT 14 1981

JOHN P. HEHMAN, Clerk

VULCAN, INC.,

Plaintiff-Appellee

v.

FORDEES CORPORATION,

Defendant-Appellant

O R D E R

Before: MARTIN, Circuit Judge; CELEBREZZE, Senior Circuit Judge; and JOINER, District Judge.*

Upon consideration of the petition for rehearing filed herein by defendant-appellant, the court concludes that the issues raised therein were fully considered upon the original submission and decision of this case.

IT IS THEREFORE ORDERED that the petition for rehearing be and it hereby is denied.

Judge Joiner dissents.

ENTERED BY ORDER OF THE COURT

John P. Hehman
Clerk

*Honorable Charles W. Joiner, United States District Judge for the Eastern District of Michigan, sitting by designation.

CERTIFICATE OF SERVICE

I hereby certify that three copies each of the foregoing Petition and the appendix have this date been served upon opposing counsel of record by mailing the same by United States mail, postage prepaid and properly addressed.

Date: ~~January~~ February 1, 1982

Thomas H. Murray
Counsel for Petitioners

Opposition

Office - Supreme Court, U.S.
FILED
MAR 3 1982
ALEXANDER L. STEVAS,
CLERK

No. 81-1452

IN THE

Supreme Court of the United States

OCTOBER TERM, 1981

FORDEES CORPORATION,

Petitioner

v.

VULCAN, INC.,

Respondent

ON PETITION FOR WRIT OF CERTIORARI FROM THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

BRIEF IN OPPOSITION

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March 3, 1982

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No. 81-1452

IN THE

Supreme Court of The United States

October Term, 1981

FORDEES CORPORATION,

Petitioner

v.

VULCAN, INC.,

Respondent

ON PETITION FOR WRIT OF CERTIORARI FROM THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

BRIEF IN OPPOSITION

This case turns entirely upon the resolution below of basic factual questions and therefore does not warrant review by this Court.

The District Court and the Court of Appeals both found that the petitioner engaged in certain activities that made it privy to a consent judgment so as to render the question of patent validity *res judicata* as to the petitioner. They also concurred in holding that petitioner's activities after entry of the consent judgment constituted infringement of the patent claim as interpreted in the consent judgment. Finally, both courts below found that the prosecution history of respondent's patent did not support petitioner's defense of file wrap-

per estoppel. These holdings were predicated on facts found by the District Court and concurred in by the Court of Appeals; facts that find substantial basis in the extensive trial record.

None of the considerations governing review on certiorari set forth in Supreme Court Rule 17 are present in this case. The decision below is not in conflict with a decision of another Court of Appeals on the same matter or in conflict with applicable decisions of this Court. Nor did the court below decide an important question of federal law "which has not been, but should be, settled by this Court." There is also nothing in this case to suggest that the Court of Appeals so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

OPINIONS BELOW

The opinion of the United States District Court for the Northern District of Ohio, Eastern Division, is reported at 450 F. Supp. 36 (N.D. Ohio 1978) and is attached to this Brief at page 1a of the Appendix.[1] The opinion of the United States Court of Appeals for the Sixth Circuit is reported at 658 F.2d 1106 (6th Cir. 1981) and is attached to the petition at page A-1 of the Appendix.[2]

---

1. For convenience, reference to the opinion of the District Court will be to both the official reporter and respondent's appendix "Res. App. p. . . . ."

2. For convenience, reference to the opinion of the Court of Appeals will be to both the official reporter and petitioner's appendix "Pet. App. p. . . . ."

JURISDICTION

The judgment of the United States Court of Appeals for the Sixth Circuit was entered on August 14, 1981. A petition for rehearing was denied on October 14, 1981. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1) (1976).[3]

QUESTION PRESENTED

None of the questions as stated by petitioner is present in this case. Petitioner's attempt to fabricate eye-catching issues cannot obscure the reality that the judgments by both courts below were not founded upon any application of the synergism doctrine. In short, the questions concerning synergism posited by petitioner are false issues.

Since the petition is premised on the dissatisfaction of petitioner with the determinations of fact made by the courts below, the question presented might more accurately and simply be stated:

> Where both lower courts concurred on the facts in holding that petitioner is privy to, and bound by, a consent judgment regarding the validity of the Titzel patent, and that petitioner's activities subsequent to the consent judgment infringed the patent as interpreted in the consent judgment, is the intervention of this Court justified?

---

3. This jurisdictional statement is included herein to clarify the basis for jurisdiction upon which petitioner appears to rely.

STATUTE INVOLVED

Section 271 of the Patent Act of 1952, 35 U.S.C. § 271(1976), reads, in relevant part, as follows:

> (a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

RULE INVOLVED

Rule 52(a) of the Federal Rules of Civil Procedure provides as follows:

> In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon, and judgment shall be entered pursuant to Rule 58; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. *Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses.* The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. If an opinion or memorandum of decision is filed, it will be sufficient if the findings of fact and conclusions of law appear therein. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41(b).

(Emphasis added).

STATEMENT OF THE CASE

This case arose as an action for infringement of United States Patent No. 3,166,154 (the "Titzel patent"), which discloses and claims a portable work tower, called a "reline tower", for use in the rebuilding of refractory lining in basic oxygen furnaces. The tower provides an integral, free-standing machine, approximately 60 feet in height and 6 feet square at its base, that can be inserted and removed in one piece through the narrow opening in a furnace vessel with an overhead crane. Vulcan, Inc., the plaintiff below and the respondent to the instant petition, is the current owner of the Titzel patent.

The Titzel reline tower is of great practical value, substantially changing the process of relining steel-making vessels. The machine rapidly carries refractory bricks and other materials to the workmen in the furnace vessel and supports the workmen at varying, select levels in the furnace vessel as they perform the relining, while protecting the workmen from the dangers inherent in prior relining practices. In sum, the Titzel reline tower advanced the art of furnace relining in several respects: the danger to workmen from falling brick was eliminated; the need for carpenters and other workmen to build and disassemble scaffolding was eliminated; the need to occupy the overhead crane throughout the relining operation was eliminated; and the time required to perform relining was substantially reduced with a corresponding increase in the steel-making capacity of the furnace.

On November 23, 1970, respondent's predecessor in interest, Titzel Engineering Company, Inc., brought suit against M&G Industrial Associates and its president, Robert N. Munroe, for infringement of the Titzel patent (W.D. Pa. Civ. Act. #70-1333). Early in 1971, Munroe

contacted Fordees' president and told him about the Titzel patent. Fordees, M&G, and Titzel were then bidding against each other for a contract to build a reline tower for the Gary Works of U.S. Steel Corporation. Fordees had never built a reline tower, and submitted its bid based upon a plan which it characterized as a "cartoon". U.S. Steel accepted Fordees' bid and signed a Purchase Order with petitioner Fordees. As a condition of the contract, Fordees specifically agreed to hold U.S. Steel harmless from potential infringement of the Titzel patent, without having its patent attorney even consider the patent.

After its bid was accepted, Fordees purchased from M&G a set of reproducible engineering drawings containing complete specifications for the construction of a reline tower. These engineering drawings were M&G's principal asset; its practice was to subcontract construction work to firms in accordance with its engineering drawings. Fordees purchased these engineering drawings from M&G with full knowledge that the reline tower they described was the subject of the patent infringement suit between Titzel and M&G. Fordees also obtained technical assistance and engineering advice from M&G to enable it to build its first reline tower, after purchasing the drawings. Because of the pending litigation, Fordees also insisted that M&G indemnify it against liability for infringing the Titzel patent.

Fordees then began to construct a reline tower for the Gary Works of U.S. Steel. Except for minor dimensional changes, it adhered to the specifications set forth in the M&G engineering drawings.

On October 14, 1971, Titzel's infringement suit against M&G and Munroe ended with the entry of a consent decree and accompanying stipulation (herein-

after referred to in combination as the "consent judgment") that declared the Titzel patent valid and infringed. In the consent judgment, M&G and Munroe stipulated to a finding that the reline tower set forth in the engineering drawings sold by M&G to petitioner Fordees, infringed the Titzel patent. Titzel Engineering Company, Inc. agreed in the consent judgment to release M&G, their customers and all others in privity with them from any and all claims of damages arising out of *prior* acts of infringement. The release thus operated for the benefit of petitioner Fordees as well as M&G and Munroe, insofar as liability for infringing activity that occurred prior to the consent judgment.

Subsequent to the entry of the consent judgment, M&G and Munroe dissolved their reline tower business. Petitioner Fordees, however, began making additional reline towers in 1973, using the engineering drawings that it had purchased from M&G prior to the entry of the consent judgment. Petitioner brought the instant infringement action in 1975. During the three-week trial, the District Court heard seven witnesses, producing 1125 pages of testimony. It also considered 158 exhibits and 10 depositions submitted at trial. At the end of the trial, the parties agreed to amendment of the pleadings to conform to the evidence; an Amended Complaint and a Supplemental Amended Answer were subsequently filed.

Detailed findings of fact and conclusions of law were entered by the District Court. Based on these findings of fact the trial court held that petitioner was in privity with M&G and was therefore bound by the prior consent judgment that decreed the Titzel patent valid and infringed. The District Court applied the doctrine of equivalents to further find that "new models" of petitioner's reline tower (built after the entry of the consent

judgment) infringed the Titzel patent as interpreted in the consent judgment. Finally, the court rejected petitioner's defense of file wrapper estoppel as not being supported by the facts as found upon the evidence.

On appeal, the United States Court of Appeals for the Sixth Circuit thoroughly reviewed the evidence and affirmed the decision of the District Court, holding the consent judgment binding on petitioner Fordees by virtue of its being in privity with M&G. In addition, the Court of Appeals concluded that the evidence supported the District Court's finding of equivalency between the Titzel patent as interpreted in the consent judgment and the reline towers built by petitioner after entry of the consent judgment. The Court observed that the Fordees towers covered by the consent judgment and those in suit after the consent judgment (shown in Plaintiff's Exhibits 99 through 106) were "virtually identical structures". The Sixth Circuit thus affirmed the District Court's holding that the reline towers built by petitioner Fordees after the consent judgment infringed the Titzel patent. Finally, the appellate court below concurred with the conclusion of the District Court that the facts did not make out a case of file wrapper estoppel and that petitioner, therefore, had no defense to the finding of infringement. Indeed, this defense too was settled by the consent judgment.

REASONS FOR DENYING THE PETITION

1. The Court Of Appeals Did Not Rely Upon Any Application Of The Synergism Doctrine In Affirming The Holding Of The District Court Regarding Patent Infringement.

It must be made clear at the outset that this case did not present the courts below with any issue concerning patent validity. Because the validity of the Titzel patent was decreed by the 1971 consent judgment, the District Court had merely to determine whether petitioner was bound by the terms of the consent judgment and whether petitioner's activities constituted infringement within the scope of the consent judgment. Petitioner's reference to the decisions of this Court in *Anderson's-Black Rock, Inc. v. Pavement Salvage Company*, 396 U.S. 57 (1969) and *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976), as well as other cases dealing with the concept of synergism as a prerequisite for patentability are, therefore, inapposite.

The consent judgment that ended the prior litigation concerning infringement of the Titzel patent by M&G stipulated to, and decreed, the validity of the Titzel patent and its infringement by the reline tower of M&G. In the instant case, the District Court found from the evidence that petitioner was in privity with infringer M&G, and was therefore bound by the prior consent judgment. The holding of patent validity and infringement in the consent judgment was properly held by the District Court to be *res judicata* as to petitioner. *See Schlegel Manufacturing Company v. USM Corporation*, 525 F.2d 775 (6th Cir. 1975), *cert. denied*, 425 U.S. 912 (1976); *Broadview Chemical Corporation v. Loctite Corporation*, 474 F.2d 1391 (2d Cir. 1973); *A. W. Schnitger v. Canoga Electronics Corporation*, 462 F.2d 628 (9th Cir. 1972); *United States ex rel. Shell Oil Company v. Barco*

Corporation, 430 F.2d 998 (9th Cir. 1970). *See also American Equipment Corporation v. Wikomi Manufacturing Co.*, 630 F.2d 544 (7th Cir. 1980); *Wallace Clark & Co. v. Acheson Industries, Inc.*, 532 F.2d 846 (2d Cir. 1976), *cert. denied*, 425 U.S. 976 (1976).

The lower court then found that differences in the reline towers made subsequent to the consent judgment by petitioner did not take it outside the scope of infringement as laid down in the consent judgment because petitioner's reline towers were based on the same principle and operated in the same manner as the Titzel reline tower. Finally, petitioner was unable to avoid liability on a theory of file wrapper estoppel because the District Court found that defense to be unsupported by the prosecution history.

The affirmance by the Court of Appeals must be analyzed in context with the disposition of this case by the trial court. As an initial matter, the Court of Appeals addressed the question of whether petitioner was foreclosed from re-examining the validity of the Titzel patent because of any *res judicata* effect of the 1971 consent judgment. Finding "unpersuasive" petitioner's argument that it was merely under license by M&G to use the engineering drawings decreed to infringe the Titzel patent, the court upheld the District Court's finding of privity, noting that

> [o]ur review of the record discloses ample evidence that Fordees' relationship with M&G was in fact "sufficiently close" to establish privity.

658 F.2d at 1109 (Pet. App. p. A-5).

Petitioner's allegation that the Court of Appeals, through an application of some form of synergism test, expanded the protection due the Titzel patent by the

doctrine of equivalents, is a confusing attempt to camouflage the true basis for affirming the District Court's holding of infringement. For, having concluded that petitioner was bound by the prior consent judgment, the Sixth Circuit then considered whether reline towers built by petitioner subsequent to the consent judgment infringed the Titzel patent. After comparing petitioner's reline towers with the scope of the Titzel claims decreed to be valid in the consent judgment, the Sixth Circuit concurred with the holding of the District Court, stating:

> We also find substantial evidence in the record to support the District Court's conclusion that the reline towers constructed by Fordees after the consent decree fall within the claims of the Titzel patent under the doctrine of equivalents. *See Graver Mfg. Co. v. Linde Air Products*, 339 U.S. 605 (1950); *Olympic Fastening Systems, Inc. v. Textron, Inc.*, 504 F.2d 609 (6th Cir. 1974), *cert. denied*, 420 U.S. 1004 (1975). Dr. Romualdi testified repeatedly and without contradiction that there is no functional difference between the Fordees towers, and the M&G tower and the Titzel patent. Furthermore, the specifications for the Fordees towers in plaintiff's exhibits 99 through 106 [covered by and subsequent to the consent judgment] show virtually identical structures.

658 F.2d at 1114 (Pet. App. pp. A-13 to A-14) (footnote omitted). *See also Schlegel Manufacturing Company v. USM Corporation*, 525 F.2d at 781.

The reference by the Court of Appeals to synergism came only in response to petitioner's arguments that sought to narrow the scope of the Titzel patent, contrary to the interpretations given in the consent judgment, to encompass only reline towers supported solely from the

base. Both the District Court and the Circuit Court concurred in rejecting such a narrow construction of the Titzel claim, concluding that base support means were not the essential teaching of the patent. It was only in describing the advances over the prior art achieved by the Titzel reline tower that the Sixth Circuit conceptualized the resultant function of the Titzel tower with a reference to synergism:

> From the foregoing examination of the Titzel patent and the prior art, we conclude that the District Court's interpretation of Titzel is legally correct. The patent's grant is broad enough to encompass a free-standing reline tower, not one which relies solely on base support means. Titzel represents a substantial advance over the prior art through a number of improvements, taken in combination. It achieves what is known in the art as "synergy"—the device as a whole is greater that the sum of its parts. For this reason, we reject Fordees' narrow reading.

658 F.2d at 1113-14 (Pet. App. p. A-13).

When considered in the proper context of this case, it is clear that the Court of Appeals used the concept of synergism as a graphic analogy to summarize the advances taught by Titzel. The reference to "synergy" was used merely to explain the court's reason for rejecting petitioner's attempt to unduly narrow the scope of the claims contrary to the decree in the consent judgment. Once it concurred with the District Court regarding the scope of the Titzel claim, the Circuit Court did not, as petitioner would lead this Court to believe, rely on any application of synergism in concluding that petitioner's reline towers infringed the Titzel patent.

Synergism was not applied by the Sixth Circuit as a measure for determining the protection to be accorded to the Titzel patent in the context of the consent judgment. Nor did any presence or absence of synergism have any effect on the two concurrent factual findings below that the prosecution history of the Titzel patent did not support petitioner's assertion of file wrapper estoppel. Because the synergism doctrine was, therefore, not applied by the Court of Appeals as a principle of law in deciding this case, petitioner's adjunct assertion of surprise in the Sixth Circuit is without substance.

2. The Findings of Fact, As Determined By The District Court And Affirmed By The Court Of Appeals, Are Supported By Substantial Evidence In The Record And Are Not Clearly Erroneous.

The petitioner Fordees is clearly unhappy with the findings of fact in which both the District Court and the Court of Appeals concurred. Those factual determinations find substantial support in the record from a trial extending over three weeks, in which seven witnesses were examined, producing 1125 pages of testimony, and 158 exhibits and 10 depositions were submitted and considered. Petitioner ignores long standing precedent by requesting that this Court 'second guess' the two courts below and conduct an independent determination of the factual issues, without a showing by petitioner of obvious and exceptional error.

It is well-established that

> [a] court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error.

Graver Tank & Manufacturing Company v. Linde Air Products Company, 336 U.S. 271, 275 (1949). *See also Goodyear Tire & Rubber Company v. Ray-O-Vac Company*, 321 U.S. 275 (1944); *Universal Oil Products Company v. Globe Oil & Refining Company*, 322 U.S. 471 (1943); *Williams Manufacturing Company v. United Shoe Machinery Company*, 316 U.S. 364 (1942). The petition does not detail any defects in the findings of fact made by the trial court that rise to the level of "a very obvious and exceptional" error.

The authority of this Court to review the facts in this case is further circumscribed by Rule 52(a) of the Federal Rules of Civil Procedure. *Zenith Radio Corporation v. Hazeltine Research, Inc.*, 395 U.S. 100 (1969); *United States v. Oregon State Medical Society*, 343 U.S. 326 (1951); *Graver Tank & Manufacturing Company v. Linde Air Products Company*, 339 U.S. 605 (1950); *United States v. United States Gypsum Company*, 333 U.S. 364 (1948). Rule 52(a) provides that where an action is tried by a court without a jury, "[f]indings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses."

The disposition of the instant case below turned on the outcome of two basic issues: 1) whether petitioner was in privity with M&G and thus bound by the terms of the consent judgment; and 2) whether the reline towers built by petitioner after the date of the consent judgment were equivalent to the patented Titzel reline tower as interpreted in the consent judgment. Although petitioner would like to alter an unfavorable resolution of these crucial issues below and relitigate the basic facts upon which the lower courts' conclusions are founded, the appellate review of such factual findings sought by

petitioner in this Court is constrained by the limitations of Rule 52(a).

The existence or nonexistence of privity in a given case is a question of fact that should not be reversed unless clearly erroneous. *Harrison v. Bloomfield Building Industries, Inc.*, 435 F.2d 1192 (6th Cir. 1970); *Astron Industrial Associates, Inc. v. Chrysler Motors Corporation*, 405 F.2d 958 (5th Cir. 1968); *Crane Boom Life Guard Company v. Saf-T-Boom Corporation*, 362 F.2d 317 (8th Cir.), *cert. denied*, 386 U.S. 908 (1966). Upon a thorough review of the record below, the Court of Appeals found "ample evidence" on which to base a finding of privity between petitioner and M&G. 658 F.2d at 1109 (Pet. App. p. A-5). Petitioner has not come forth with any reason why any finding of fact is clearly erroneous.

The holding of infringement by the District Court, while itself a conclusion of law, was compelled by that court's finding of substantial identity between petitioner's reline towers made after entry of the consent judgment, and the reline towers and the patent claim as adjudged to infringe and to be infringed in the consent judgment. The latter determination was also one of fact, made after a thorough consideration and weighing of all the evidence. *E.g., Graver Tank & Manufacturing Company v. Linde Air Products Company*, 339 U.S. 605 (1950); *Schlegel Manufacturing Company v. USM Corporation*, 525 F.2d at 782, *Olympic Fastening Systems, Inc. v. Textron, Inc.*, 504 F.2d 609 (6th Cir. 1974), *cert. denied*, 420 U.S. 1004 (1975). Although petitioner engages in speculation regarding the possibility of confusion in the courts below, the District Court and Court of Appeals each construed the scope of the Titzel patent from its own study of the patent claims, the file wrapper history and the prior art. The Circuit Court summed up the

substantial evidence in the record to support the conclusion as follows:

> Dr. Romualdi testified repeatedly and without contradiction that there is no functional difference between the Fordees towers, and the M&G tower and the Titzel patent. Furthermore, the specifications for the Fordees towers in plaintiff's exhibits 99 through 106 show virtually identical structures. This evidence supports the District Court's finding of equivalency.

658 F.2d at 1114 (Pet. App. p. A-14) (footnote omitted.).

Finally, the Sixth Circuit concurred with the District Court in holding that the facts found by the trial court were insufficient to establish file wrapper estoppel as asserted by petitioner. In particular, petitioner argued at trial that the Titzel patent was allowed only after the claims were restricted by the inventor as teaching only base means support for the tower structure. The District Court found to the contrary, however, that "[t]hose erroneous representations regarding base means support on which defendant relie[d] in raising file wrapper estoppel were rejected, and complete rewording and change of emphasis of the claim were required by the Patent Office to achieve patentability." 450 F. Supp. at 43 (Res. App. p. 14a). In concurring that file wrapper estoppel was not warranted by the evidence, the Sixth Circuit also rejected petitioner's version of the prosecution history, noting that "Fordees has taken the remarks in Titzel's file history out of context. The language is not as limited as Fordees suggests." 658 F.2d at 1114 (Pet. App. p. A-16).

The factual findings in the instant case were based on a thorough consideration of all the evidence by both

courts below. In addition, petitioner has not raised any claim of irregularity in the findings of fact below, but rather reargues the facts as he believes them to be, and attacks the credibility of particular witnesses. There is no reason for this Court to deviate from the requirement of Fed. R. Civ. P. 52(a) that "due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses."

Petitioner would have this Court wade through, and decide anew, the crucial facts in the instant case despite the admonition of this Court that

> [i]t is not for this Court to even essay an independent evaluation of this evidence. This is the function of the trial court.

Graver Tank & Manufacturing Company v. Linde Air Products Company, 339 U.S. 605, 611 (1950). Contrary to petitioner's assertions, an understanding of the evidence in this case precludes any "definite and firm conviction that a mistake has been committed." *Zenith Radio Corporation v. Hazeltine Research, Inc.*, 395 U.S. 100, 122 (1969); *United States v. Oregon State Medical Society*, 343 U.S. 326, 339 (1951); *United States v. United States Gypsum Company*, 333 U.S. 364, 395 (1948).

The essence of petitioner's arguments is that the District Court should have weighed the evidence according to a formula that would have produced factual determinations supportive of petitioner's theory of the case. Petitioner has even failed, however, to establish a grievance here that it might have in a case where the evidence would support a conclusion either way but where the trial court has decided to weigh it more heavily for the respondent. "Such a choice between two permissi-

ble views of the weight of evidence is not 'clearly erroneous.' " *United States v. Yellow Cab Company*, 338 U.S. 338, 342 (1949). *See also United States v. Singer Manufacturing Company*, 374 U.S. 174, 202 (1963) (Harlan J., dissenting). In short, the findings of fact by the District Court, in which the Sixth Circuit concurred, are invulnerable to attack under Rule 52(a) of the Federal Rules of Civil Procedure, and do not warrant review by this Court.

CONCLUSION

The petition for writ of certiorari should be denied.

Respectfully submitted,

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March 3, 1982

Appendix

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO
Eastern Division

VULCAN, INC.,
Plaintiff
v.
FORDEES CORPORATION,
Defendant

No. C 75-54 Y

MEMORANDUM OPINION AND ORDER WITH FINDINGS OF FACT AND CONCLUSIONS OF LAW

Before: LAMBROS, *District Judge.*

INTRODUCTION

The essence of this action is patent infringement. The patent in issue is U.S. Patent No. 3,166,154, granted January 19, 1965 (the "Titzel patent"). The accused devices are portable work towers ("reline towers") manufactured by Fordees Corporation ("Fordees"). This action involves both the questions of validity and infringement of the Titzel patent. Plaintiff has asserted that a prior consent judgment is dispositive of the issue of validity. Further, contending that later Fordees devices were equivalent to those previously declared infringing, plaintiff contends the prior judgment is also dispositive of the question of infringement.

While the issues relative to the consent judgment may be dispositive of this action, this cause came on to be heard not only upon those issues associated with the consent judgment, but also upon the issues of validity and infringement considered separate and apart from the consent judgment, solely as to the relationship of each of these issues to the question of liability in this action.

FINDINGS OF FACT

1. Plaintiff Vulcan, Inc. ("Vulcan") is a Pennsylvania corporation having its principal place of business at Latrobe, Pennsylvania. Plaintiff's Vulcan Engineering Division is by acquisition, merger and change of name successor to Titzel Engineering, Inc. ("Titzel Engineering").

2. Defendant Fordees Corporation is an Ohio corporation having its principal place of business at Leetonia, Ohio.

3. The Titzel patent was issued to Titzel Engineering as assignee of John M. Titzel. Titzel Engineering was plaintiff's predecessor in title. John M. Titzel is the originator of the subject matter described and claimed in U.S. Patent No. 3,166,154.

Nature of the patent.

4. Basic oxygen furnaces, used for the purpose of making steel, have refractory linings to retain molten metal and to insulate the vessel from overheating during processing. Over a period of use, these refractory linings are gradually eaten away. Every so often, such vessels must be taken out of service and the refractory lining replaced.

5. Before the concept of reline towers, relining of basic oxygen furnaces was done by use of scaffolding which was built up piece-by-piece. The process of relining then required one set of people building the scaffolding and another set of people to perform the actual relining. The scaffolding would be built up several feet, and then the refractory lining would be built up several feet. This procedure was repeated until the vessel was completely relined. Upon completion of the relining, the scaffolding

was disassembled and removed from the vessel. This method of relining took several days, with concomitant loss of steel-producing capacity. The method required use of the overhead mill crane to lower refractory bricks to the workmen. The method involved lowering pallets of these bricks directly over the heads of workmen, with corollary potential danger.

6. The Titzel patent is for a portable work tower, called a "reline tower", for use in the rebuilding of refractory lining in basic oxygen furnaces. The patent contains four claims, three of which are dependent on Claim 1. Claim 1 is the only independent claim and the one charged to be infringed. Claim 1 defines the invention of the Titzel patent as follows:

> 1. A portable work tower particularly adapted for use in vessels having an opening smaller than the interior comprising an elongated tower means adapted to pass through the opening in said vessel and be normally free standing, said tower means including upper and lower portions having spaced apart vertically extending members at the corners of a quadrangle, said vertically extending members on the lower portion being provided with carrier means vertically movable thereon, base means on the lower portion adapted to engage the vessel bottom at spaced apart adjustable level points whereby the tower may be levelled and supported, a plurality of support arms spaced about said carrier means and pivoted thereon from a position parallel to the lower portion of the tower to a position transverse to the tower means to form a working platform, spaced cage guides within the upper and lower portions forming an inner cage guide extending from adjacent one end of the tower to the opposite end of said

tower, cage means vertically movable on said cage guides within the upper and lower tower portions and lift means on the tower means selectively raising and lowering the cage means, said cage means being selectively coupled with said carrier means for raising and lowering said carrier means with said cage means.

7. The salient features of the Titzel patent are, in combination: (i) a radially foldable working platform formed by support arms mounted on a carrier means that can be moved vertically along vertically extending frame members and selectively locked at numerous locations and work levels; (ii) a guided cage inside the vertically extended members for carrying refractory brick and other materials in bulk into the vessel to the working platform through the interior of the tower, and (iii) selective coupling of the guided cage to the working platform to raise and lower the working platform to different elevations within the vessel by the same lift means used to raise and lower the cage without affecting the structural rigidity of the tower.

8. Reline towers of the sort set forth in the Titzel Patent substantially changed the practice in relining a basic oxygen furnace. They are integral, free-standing machines, which can be inserted through the narrow opening in a furnace vessel in one piece. They eliminate the danger to workmen from falling brick; they eliminate the need for workers to build and disassemble scaffolding; they eliminate the need for use of the overhead crane during the relining operation; and they reduce the time required to perform relining, with a concomitant increase in potential steel production.

9. The reline towers of the Titzel patent were quickly adopted and have achieved continuous widespread use since 1961.

10. The combination of elements in the Titzel structure produces a result of great practical value in relining basic oxygen furnaces.

11. The file history of the Titzel patent shows original rejection of claims which included base means for support and for adjustably positioning the tower vertically. After amendment of claims 1, 3, 5 and 7 to reflect base means on the tower adapted to engage the vessel bottom and provide support for the tower, Titzel's application for patent was still rejected. Titzel's application was granted only after Titzel amended his application by cancelling all claims and setting forth an entirely new set of claims.

Fordees' relationship with M&G.

12. Titzel Engineering, the predecessor to Vulcan, brought an action against M&G Industrial Associates, Inc. (M&G) and Robert N. Munroe (Munroe) on November 23, 1970. This action was brought in the United States District Court for the Western District of Pennsylvania as Civil Action No. 70-1333. The action was for infringement of the Titzel patent. Plaintiff in that action claimed infringement on the basis of the manufacture and sale of reline towers by M&G.

13. In early 1971 Mr. Munroe, of M&G, advised Mr. Sause, President of Fordees, of the Titzel patent. At that time Fordees, M&G and Titzel Engineering were all bidding against one another for a contract to provide a reline tower for the United States Steel Corporation (U.S. Steel). This reline tower was to be used at U.S. Steel's Gary Works (BOP No. 2).

14. Fordees' bid was accepted by U.S. Steel through a purchase order dated March 9, 1971. As a condition of the contract, Fordees agreed to hold U.S. Steel harmless from any infringement specifically by reason of the Titzel patent.

15. Prior to successfully bidding on the U.S. Steel contract, Fordees had never built a reline tower for a basic oxygen furnace. Fordees bid for the U.S. Steel contract largely on the basis of a drawing characterized as a "cartoon". This drawing could not have been used to build an actual reline tower.

16. After successfully bidding on the U.S. Steel contract, Fordees purchased the only set of engineering drawings M&G appears to have sold setting forth how to build an M&G reline tower. Fordees purchased these drawings with full knowledge that the reline tower set forth by the drawings was the subject of pending litigation against M&G for infringement of the Titzel patent. After purchasing the drawings, Fordees obtained additional engineering and technical assistance from M&G in relation to construction of the M&G reline tower.

17. M&G did not make reline towers, but subcontracted that work to others to build in accordance with engineering drawings M&G supplied. M&G's prime asset in relation to reline towers was its engineering drawings, which expressed the combined efforts of its engineers and in addition to fully detailing the reline tower, stated the details of the components to be made and the descriptions and suppliers of the components to be purchased.

18. Because of the patent infringement litigation on the Titzel patent, Fordees insisted upon and received from M&G, in addition to the M&G reline tower engi-

neering drawings, an indemnity over the signature of Munroe.

19. Fordees received reproducible copies (mylars) of the engineering drawings of M&G to the reline tower shown in Plaintiff's Exhibit 55. Fordees' engineer, Mr. Hively, reviewed the drawings and secured additional engineering drawings and information.

20. Fordees made its first reline tower for the Gary Works (BOP No. 2) of U.S. Steel largely in accordance with the M&G engineering drawings. The only differences were dimensional changes to fit the tower to the particular furnace vessel and certain changes made at the direction of U.S. Steel.

21. On October 14, 1971, the United States District Court for the Western District of Pennsylvania entered both a stipulation upon entry of a consent decree and a consent decree ending the litigation involving M&G and Munroe as defendants and Titzel Engineering as plaintiff. The consent judgment found the Titzel patent valid and infringed. In the judgment, M&G and Munroe agreed to a finding that the reline tower set forth in the engineering drawings supplied by them to Fordees infringed the Titzel patent; and in accordance with the judgment, delivered up to Vulcan copies of those engineering drawings, which are here in evidence as plaintiff's exhibit 55. The judgment found that five reline towers infringed the Titzel patent, four of which were made by M&G and one of which was made by Fordees in connection with M&G.

22. As part of the settlement, the plaintiff agreed to release defendants from any infringing acts prior to the date of the settlement, with a view to releasing Fordees from liability on the reline tower then in construction for the U.S. Steel Gary Works.

23. M&G closed its business upon entry of the consent judgment, and Munroe got out of the reline tower business in favor of becoming involved in a steel fabricating firm.

Comparison of Fordees Reline Towers with M&G Reline Tower

24. In 1973, Fordees began making additional reline towers with full knowledge of the existence of the Titzel patent and with full knowledge of the 1971 consent judgment. Fordees bid and received a contract to build a second reline tower for the Gary Works (BOP Shop No. 1) of U.S. Steel. Fordees gave U.S. Steel a hold harmless against patent infringement, specifically mentioning the Titzel patent.

25. The second reline tower built by Fordees for the Gary Works of U.S. Steel was (and is), in relation to the Titzel patent, equivalent in every respect to the first reline tower made by Fordees for the Gary Works of U.S. Steel and to the M&G reline tower shown in Plaintiff's Exhibit 55 and adjudicated to infringe by the consent judgment. The Fordees second reline tower, as well as the Fordees first reline tower and the M&G reline tower adjudicated to infringement, were portable work towers particularly adapted to be transported by the overhead mill crane and to pass through the narrow opening in the top of a steelmaking vessel. The towers are designed to operate without continuous support from an overhead crane. The towers each had spaced apart vertically extending members at the corners of a quadrangle, a vertically moveable carrier provided on the lower portions of the tower within the vessel, a plurality of support arms spaced about the carrier and pivoted thereon from a position parallel to the lower portion of the tower to a

position transverse to the tower to form a working platform, spaced cage guides within the upper and lower portions of the tower forming an inner cage guide extending from adjacent one end of the tower to the opposite end of the tower, a cage vertically moveable on the cage guides within the upper and lower portions of the tower which can be raised and lowered in conjunction with a lift hoist on the tower, and means for connecting the carrier with the cage for raising and lowering the carrier and working platform with the cage and the same lift hoist.

26. The second and subsequent Fordees towers differed from the M&G and first Fordees tower in only one significant respect: the later Fordees towers had no base stabilizing means. Neither the shock absorbers on the elevator cage nor certain screws on the scaffold of the later Fordees reline towers comprise the recited base means of the first claim of the Titzel patent.

27. Both the M&G and Fordees reline towers were primarily supported from the service floor.

28. Since the consent judgment, Fordees has also built reline towers substantially equivalent to the M&G design for CSN and Youngstown Sheet and Tube Company. These third and fourth reline towers were (and are) equivalent in every respect to the second reline tower made by Fordees.

29. Fordees is also presently building or has built a fifth reline tower similar to the M&G design for the Burns Harbor Works of Bethlehem Steel Corporation. The tower is of substantially the same design as Fordees' second reline tower except it has four doors on the carrier at the working platform instead of two doors.

30. Notwithstanding lack of inclusion of base means support as set forth in the claim of the Titzel patent, Fordees' second and subsequent reline towers appropriate the basic principle and mode of operation of the device set forth in the Titzel patent. Both the Fordees' towers and the Titzel reline tower obtain their results by the same or equivalent means.

31. While Fordees' towers employ a different method for selectively coupling or connecting the carrier means with the cage means than that method set forth in diagrams appended to the claims of the Titzel patent, the Fordees towers nonetheless employ the same concept of coupling the two means to raise or lower them together by a single hoist. The modes of operation of the patented tower and Fordees' towers in this respect, notwithstanding substitution of retractable table beams for hooks and latches, are equivalent.

32. Each of the reline towers made by Fordees after the consent judgment, like the reline towers made by it and M&G previously, is "normally free-standing" as called for by claim 1 of the Titzel patent. "Free-standing" requires that the structure remain stable in position without the use of support means such as cables, overhead cranes and special frames brought in for the specific purpose of holding it in place. Each of the Fordees reline towers is stable in position on a primary foundation at the service floor with various means to stabilize and support the tower within the vessel. Admittedly, no cables, braces, overhead cranes or other ancillary devices are brought in for the specific purpose of maintaining the stability of the structure. The requirement that the tower be free standing does not require or imply that the structure is totally supported from its bottom or base.

33. The greater rigidity claimed of the Fordees towers is not a significant difference between Fordees' and Vulcan's towers, notwithstanding the addition of certain cross-bracing.

Base Means Support

34. Titzel's original claims were rejected as unpatentable. The application's independent claims were then amended to call for base means support, with the remark that the device was the first to provide its major support from the bottom and entirely eliminate all top support. This remark was erroneous on the record then before the Patent Office because the amendatory language was not limited to provide major support from the vessel bottom, claims five and seven then before the Patent Office required outrigger members, and the application taught levelling means at the top of the tower and in the outrigger.

35. The Patent Office specifically rejected these proposed claims and remarks on October 30, 1963.

36. The applicant then redefined and reworded his claims, completely substituting all prior claims with what is now the Titzel patent. The claims as issued did not require that the tower have its major support or be supported solely from the bottom of the vessel. Prior claims and remarks to that effect were rejected before applicant amended his claims, and were not relied on by the Patent Office in finding patentability.

37. The patent as issued does not solely teach base means support. As issued, the patent describes a reline tower that is free-standing. Each of the reline towers that are the subject of this action are in conformity with and satisfy the essential claim of the Titzel patent. De-

fendant's accused reline towers incorporate the equivalent structure described and claims in the Titzel patent.

CONCLUSIONS OF LAW

A consent judgment binds not only the named parties to the judgment, but also those in privity with them. *Schlegel Manufacturing Co. v. USM Corp.*, 525 F.2d. 775 (6th Cir. 1975), *cert. denied*, 96 S. Ct. 1509 (1976); *Brunswick Corp. v. Chrysler Corp.*, (7th Cir. 1969); *Crane Boom Life Guard Co. v. Saf-T-Boom Corp.*, 362 F.2d 317 (8th Cir. 1966), *cert. denied* 87 S. Ct. 853 (1967). A holding in a consent judgment that a patent is valid and infringed is *res judicata* as to the parties and their privies on the issue of validity of the patent in subsequent litigation. *Schlegel Manufacturing Co. v. USM Corp., supra; Broadview Chemical Corp. v. Loctite Corp.*, 474 F.2d 1391 (2d Cir. 1973); *United States ex rel. Shell Oil Co. v. Barco Corp.*, 430 F.2d 998 (9th Cir. 1970).[1]

Where, as here, during the pendency of a patent infringement suit, Fordees acquired from the defendant in the suit property rights to designs and engineering and technical assistance permitting Fordees to manufacture the device which is the subject of that suit; where such acquisition is made with full knowledge of the pendency of the suit; where the defendant in the suit agreed to indemnify Fordees for any damages resulting from Fordees' infringement of the patent in suit; where a consent judgment was negotiated in the action which benefitted Fordees; and where the consent judgment

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1. The doctrine of res judicata thus bars all defendant's defenses as to validity, such as fraud on the patent office, want of adequate specifications, lack of utility, anticipation, and obviousness.

holds the patent valid and infringed; the Court finds Fordees is in privity with the defendant in the suit. See *A.W. Schnitger v. Canoga Electronics Corp.*, 462 F.2d 628 (9th Cir. 1972); *J.R. Clark Co. v. Jones & Laughlin Steel Corp.*, 288 F.2d 279 (7th Cir. 1961), *cert. denied* 368 U.S. 828 (1961); *Alb, Inc. v. Noma Lites Inc.*, 231 F.2d 662 (2d Cir. 1956).

Therefore, Fordees was in privity with M&G as to the consent judgment. Where a party is bound by a prior consent judgment decreeing validity and infringement of a patent, the prior judgment is *res judicata* on the question of patent validity. The only issues remaining are enforcement of the decree and infringement by new models. *Brunswick Corp. v. Chrysler Corp., supra.*

The major differences in form between Fordees' second and subsequent towers and the reline tower of the Titzel patent are: (1) the selective coupling of the cage and carrier means, while existent in both towers, is achieved differently, and (2) Fordees' second and subsequent towers have no base means support.

The difference in method employed to achieve selective coupling is merely a difference in form, and does not take the Fordees towers outside the scope of the claim of selective coupling set forth in the Titzel patent. Further, this difference in selective coupling does not affect the principle or mode of operation of the patented device.

The lack of base means support in Fordees' second and subsequent towers does indeed result in the omission of one element of a claim of the Titzel patent. However, this omission does not materially affect the principle or mode of operation of the patented device.

Incorporation of each and every element, without exception, of every claim of a patented structure is not an absolute prerequisite to a finding of infringement by an accused structure. *Clarage Fan Co. v. B & F Sturtevant Co.*, 148 F.2d 786 (6th Cir. 1947); see also *Abbott v. Barrentine Manufacturing Company*, 255 F.Supp. 890 (N.D. Miss. 1966). In the instant case, while omitting one and only one element of one claim of the patent, Fordees' reline towers are based on the same principle and operate in the same manner as the patented reline tower. Although form has added weight in determining infringement where it is the essence of the invention, mode of operation is always a relevant consideration where the patented structure has operational characteristics. *National Rolled Thread Die Company v. E.W. Ferry Screw Products, Inc.*, 541 F.2d 593 (6th Cir. 1976).

To the extent there has been resort to the doctrine of equivalents in finding infringement of later devices, file wrapper estoppel does not preclude a finding of infringement. The facts on which defendant asserts such estoppel do not form adequate foundation for its application. Those erroneous representations regarding base means support on which defendant relies in raising file wrapper estoppel were rejected, and complete rewording and change of emphasis of the claim were required by the Patent Office to achieve patentability.

As a general rule, the validity of a patent is a matter of public importance which should always be fully explored. *Kearney & Trecker Corp. v. Cincinnati Milacron Inc., supra; Performed Line Products Co. v. Fanner Manufacturing Co.*, 328 F.2d 265, 267 (6th Cir.), *cert. denied*, 379 U.S. 846, 85 S.Ct. 56 13 L.Ed. 2d 51 (1964). However, this Circuit has held that a consent decree adjudicating

validity and infringement of a patent is *res judicata* as to the parties and their privies, on the basis that the judicial involvement in a consent decree is sufficient, in terms of the public interest, to justify application of the doctrine of res judicata to the parties and their privies. *Schlegel Manufacturing Co. v. USM Corp., supra.*

Accordingly, the Court views the consent judgment as controlling, finds said consent judgment res judicata as to defendant Fordees, and declares the Titzel patent valid as to this defendant. Further, the Court finds that Fordees' second and subsequent towers under the terms and conditions of the prior consent judgment, infringe the Titzel patent.

The Court finds this is not an exceptional case warranting award of attorney fees pursuant to 35 U.S.C. § 285. The Court defers its decision on whether to increase damages under 35 U.S.C. §284 until such time as an accounting has been made.

Validity and infringement having been found pursuant to the previous consent decree, the only issue remaining is that of an accounting. Thus, this is an appealable interlocutory decision under the terms and provisions of 28 U.S.C. § 1292(a)(4).

The Court defers ordering the parties to proceed to an accounting until such time as any appeals from this order have been completed.

IT IS SO ORDERED.

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THOMAS D. LAMBROS
United States District Judge

DATED: February 16, 1978